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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1884.

No. 1044.

BENJAMIN BUTTERWORTH, COMMISSIONER OF PATENTS OF THE UNITED STATES, APPELLANT,

VS.

SAMUEL HILL, BENJAMIN B. PRENTICE, AND THE VERMONT FARM MACHINE COMPANY.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF VERMONT.

FILED OCTOBER 10, 1884.

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1 In the circuit court of the United States for the district of Vermont.

Samuel Hill, Benjamin B. Prentice, and the Vermont Farm Machine Company
vs.
The Commissioner of Patents of the United States of America.

Be it remembered, that on the 12th day of October, A. D. 1883, Samuel Hill, a citizen of the State of Vermont, resident in the town of Greensboro', in the county of Orleans, within said State, and Benjamin B. Prentice, a citizen of the State of Vermont, resident in the town of Hardwick, in the county of Caledonia, in said State, and the Vermont Farm Machine Company, a joint stock corporation organized under the laws of the State of Vermont, and located at Bellows Falls, within said State, filed in the circuit court for the second circuit of the United States, within and for the district of Vermont, its bill of complaint against the Commissioner 2 of *Pensions* of the United States of America, which said bill of complaint is in the words and figures following:

United States circuit court, second circuit, district of Vermont. In equity.

Samuel Hill, Benjamin B. Prentice, and the Vermont Farm Machine Company
v.
The Commissioner of Patents of the United States of America.

To the honorable the judges of the United States circuit court within and for the second circuit and the district of Vermont.

Samuel Hill, a citizen of the State of Vermont, resident in the town of Greensboro', in the county of Orleans, within said State, and Benjamin B. Prentice, a citizen of the State of Vermont, resident in the town of Hardwick, in the county of Caledonia, in the State of Vermont, and the 3 Vermont Farm Machine Company, a joint stock corporation organized under the laws of the State of Vermont and located at Bellows Falls, within said State, bring this their bill of complaint against the Commissioner of Patents of the United States of America, and thereupon your orators complain and say, that prior to the 30th day of March, A. D. 1880, said Samuel Hill and said Benjamin B. Prentice were the original and first and joint inventors of a certain new and useful and patentable improvement pertaining to milk-setting apparatus, not known or used by others before their said invention thereof, and not patented or described in any printed publication before their said invention thereof, which said invention was never abandoned by said Hill and Prentice, and was not in public use or on sale for more than two years prior to their hereinafter mentioned application for letters patent therefor; and thereupon said Hill and Prentice, on or about the 30th day of March, 1880, filed in the Patent Office of the United States of America a due, legal, lawful, and proper ap-

plication for letters patent upon said improvement, and, as regards
4 said application, in all things complied with the statutes of the United States in such cases made and provided and with the regulations of the Patent Office in such cases made and provided, which applications for letters patent is still pending before the Patent Office, as by a certified copy of said application and of all the proceedings therein, filed in court with this bill of complaint, fully appears.

Your orators further show unto your honors that as a part of, and during the pendency of said application, and as a part of the specification of said invention, said Hill and Prentice made different claims or clauses of claims of invention, which, as said application at present stands, are nine in number, and the first four thereof have been rejected by the Commissioner of Patents on the ground that the subject-matter thereof is shown and described, but not claimed, in a prior patent for milk-setting apparatus granted for the invention of said Hill and Prentice, No. 207738, and dated September 3d, 1878, while the Commissioner of Patents
5 concedes and decides that the improvements in milk-setting apparatus described in said pending application for patent and recited in said first four claims of invention are novel and patentable. Said first four claims or clauses of claim are as follows, to wit:

1. "The open-top cooler tank combined with the milk vessel, having a non-central outlet, and its bottom descending throughout its whole extent to said outlet, substantially as described and for the purposes set forth.

2. "The combination of a box, an open-top cooler tank within the box, a milk vessel within and extending below the cooler tank, having at its lower end an outlet, a cock, and a transparent pane, substantially as described and for the purposes set forth.

3. "The combination of a box, an open-top cooler tank within the box, and a milk vessel extending through and below said tank, and having at its lower end a contracted outlet, a cock, and a transparent pane, substantially as described and for the purposes set forth.

6 4. "The combination of a cooler tank, the milk vessel extending below the tank, an outlet at the lower end of said milk vessel, a cock in said outlet, and the box and its cover enclosing the sides and top of the cooler tank, the whole being mounted on proper supports, substantially as described and for the purposes set forth."

Your orators further show unto your honors that said letters patent No. 207738, and all the rights and privileges granted and secured thereby, have been duly conveyed to said Vermont Farm Machine Company by an assignment made by said Hill and Prentice, dated April 3d, 1879, and duly recorded in the Patent Office; and also that the invention forming the subject-matter of said pending application, and all rights to letters patent therefor, have been duly conveyed to said Vermont Farm Machine Company by an assignment made by said Hill and Prentice, dated September 12th, A. D. 1881, and duly recorded in the Patent Office.

Your orators further complain and say that said decision of the
7 Commissioner of Patents, refusing the grant of a patent containing said first four claims of invention, is unlawful and wrongful. Whereupon your orators pray your honors to inquire into the premises and to adjudge and decree that said Hill and Prentice, as inventors, and said Vermont Farm Machine Company, as the assignee of said inventors,

are entitled according to law to receive and have a patent for the said invention of Hill and Prentice as specified in their said first four clauses of claim, and that your orators may have such other or further relief as the nature of the case may require and to your honors may seem meet.

May it please your honors to grant unto your orators not only the writ
of injunction conformable to the prayer of this bill, but also a writ of
subpœna directed to said Commissioner of Patents commanding him on
a day certain therein to be named, to be and to appear in this court, then
and there to answer the premises and to stand to, perform, and abide
8 by such further order, directions, and decree as may be made against
said defendant.

And your orators as in duty bound, will ever pray, &c.

VERMONT FARM MACHINE COMPANY,
By JAMES B. WILLIAMS, *President.*
KITTREDGE HASKINS,
Solicitor for Complainants, Brattleboro', Vt.
WM. EDGAR SIMONDS,
Of counsel for Claimants.

STATE OF CONNECTICUT,
County of Hartford, ss:

At Hartford, in said county of Hartford and State of Connecticut, per-
sonally appeared James B. Williams, and deposed that he is the president
of the Vermont Farm Machine Company, named in the foregoing bill
of complaint; that he has read said bill and knows the contents thereof,
and that the allegations thereof are true of his own knowledge ex-
9 cept as to those matteres therein stated on information and belief,
and as to such matters he believes it to be true.

JAMES B. WILLIAMS.

Before me this 25th day of September, A. D. 1883.
[L. S.] ALBERT C. TANNER,
Notary Public.

And afterwards, and on the same 12th day of October, A. D. 1883, a subpœna was issued out of this court, which was duly returned October 23d, A. D. 1883, with service accepted in writing thereon; which said subpœna and acceptance of service is in the words and figures, following:

The President of the United States of America, to the Commissioner of Patents of the United States of America, greeting:

You are hereby commanded that you and each of you personally
10 appear before the judge of the circuit court of the United States
for the district of Vermont, in the second circuit, at Burlington, in
said district, on the fifth day of November, 1883, at 10 o'clock a. m., to
answer to a bill of complaint exhibited against you in the said court by
Samuel Hill, a citizen of the State of Vermont, resident in the town of
Greensboro', in the county of Orleans, within said State, and Benjamin B.
Prentice, a citizen of the State of Vermont, resident in the town of Hardwick, in the county of Caledonia, in the State of Vermont, and the Vermont Farm Machine Company, a joint stock corporation organized under
the laws of the State of Vermont, and located at Bellows Falls within

said State, and further to do and receive whatever said court shall have considered in that behalf; and this you are by no means to omit.

Witness the honorable Morrison R. Waite, Chief Justice of the Supreme Court of the United States, at the city of Burlington, in said Vermont district, the 12th day of October, eighteen hundred and 83, and of the independence of the United States the 108th.

11 [L. S.] GEO. E. JOHNSON,
Deputy Clerk.
KITTREDGE HASKINS,
Solicitor for Orators.

WASHINGTON, D. C., *October* 18*th*, 1883.

I hereby accept service of the within subpœna, to have the same effect as if duly served on me by a proper officer, and I do hereby acknowledge the receipt of a copy thereof.

E. M. MARBLE,
Com's'r of Patents.

(Office of Com'r of Patents. Received Oct. 18, 1883.)

And afterwards, and on said 23d day of October, A. D. 1883, a letter from the Commissioner of Patents was filed, which said letter is in the words and figures following:

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., October 18, 1883.

12 SIR: I am in receipt of your letter of the 16th instant, enclosing copy of a bill of complaint entitled Hill & Prentice et al., v. The Commissioner of Patents of the United States of America, in the United States circuit court for the district of Vermont, praying that said court direct the Commissioner of Patents to issue a patent to the assignees of Hill & Prentice for the invention disclosed and claimed in their application filed in this office March 30, 1880, for an improvement in milk coolers; also a subpœna to appear and answer to said bill on the 5th proximo and a certified copy of said subpœna. I herewith return the subpœna, service accepted, and have to inform you that I shall not appear in defense in said bill.

Very respectfully,

E. M. MARBLE,
Commissioner.

Mr. W. E. SIMONDS,
Hartford, Conn.

13 And afterwards, and on the 5th day of November, A. D. 1883, being the return day of said subpœna, said bill of complaint was taken pro confesso for want of an appearance.

And afterwards, and during the October term, A. D. 1883, of this court, said cause came on for hearing before the honorable Hoyt H. Wheeler, district judge of the United States within and for the district of Vermont, sitting in equity.

And afterwards, and on the 28th day of January, A. D. 1884, a decision was filed in said cause, which said decision is in the words and figures following:

Circuit court of the United States, district of Vermont.

VERMONT FARM MACHINE COMPANY and others
vs.
E. M. MARBLE, COMMISSIONER OF PATENTS.
In equity.

14 WHEELER, *J.* The orators on the thirtieth of March, 1880, filed an application for a patent for improvements in milk-setting apparatus, consisting, as finally amended, of nine claims, the last five of which have been allowed; the first four have been refused, because described, although not claimed, in a prior patent to the same inventors, No. 207738, dated September 3, 1878. Prior public use to bar the patent is denied on oath by the applicants, and is not shown. The refusal rests solely, apparently, on the prior description, and Campbell vs. James (104, U.S. 356). What is said in that case, taken at large, would seem to show that a patent could not be granted for an invention described in a former patent to the same inventor. What was so spoken of there had been not only described but patented in the former patent. What was said is to be understood by reference to what it was spoken of. That part of that case relied upon in this rejection is where it is said:

"It is hardly necessary to remark that the patentee could not
15 include in a subsequent patent any invention embraced or described in a prior one granted to himself, any more than he could an invention embraced or described in a prior patent granted to a third person. Indeed, not so well, because he might get a patent for an invention before patented to a third person in this country if he could show that he was the first and original inventor, and if he should prove an interference declared." (Page 382.)

The latter part of this extract relates to the same subject as the former part. It expressly refers to patented inventions by others, and serves to show that patented inventions by the same inventor were intended where inventions embraced or described in his prior patent were referred to. The statute does not make prior description in a patent a bar, but being patented (sections 4886, 4887, 4920). The court appears to have merely referred to the plain effect of these statute provisions. In Battin v. Taggert, 17 How., 74, it appears to have been expressly adjudged upon the
16 same statute provisions as are in force now, that an inventor might have a patent for an invention described in a prior patent to himself. The same seems to have been decided in Graham v. McCormick (11 Fed. Rep., 859), on full argument and much consideration. According to the terms of the statutes the orators seem to be entitled to the patent for these claims. There does not appear to be any settled construction to control otherwise.

Let there be a decree for the applicant adjudging that he is entitled to receive a patent for the invention covered by these first four claims of his application.

And afterwards, and on the 9th day of February, A. D, 1884, a decree was filed in said cause, which said decree is in the words and figures following:

At a stated term of the circuit court of the United States of America for the district of Vermont, in the second circuit, held at Rutland,
17 on the first Tuesday of October, A. D. 1883.

Present, the Hon. Hoyt H. Wheeler, district judge.

SAMUEL HILL, BENJAMIN B. PRENTICE, AND The Vermont Farm Machine Company,
v.
THE COMMISSIONER OF PATENTS.
} In equity.

This cause having been heard upon the pleadings and proofs, it is hereby ordered, adjudged, and decreed that said Samuel Hill and Benjamin B. Prentice, as inventors, and said Vermont Farm Machine Company, as assignee of said inventors, are entitled to have issued to them letters patent of these United States as prayed for in the petition and bill of complaint filed in this cause, to wit, upon the application for letters patent for certain new and useful improvements pertaining to milk-setting apparatus, by said Hill and Prentice, filed in the Patent Office March 30th, 1880, containing claims or clauses of claims of invention as follows:

18 1. The open-top cooler-tank combined with the milk vessel, having a non-central outlet, and its bottom descending throughout its whole extent to said outlet, substantially as described and for the purposes set forth.

2. The combination of a box; an open-top cooler-tank within the box; a milk vessel within and extending below the cooler-tank, having at its lower end an outlet, a cock and a transparent pane substantially as described and for the purposes set forth.

3. The combination of a box; an open-top cooler-tank within the box; and a milk vessel extending through and below said tank, and having at its lower end a contracted outlet, a cock, and a transparent pane, substantially as described and for the purposes set forth.

4. The combination of the cooler-tank; the milk vessel extending below the tank; an outlet at the lower end of said milk vessel; a cock in said outlet; and the box and its cover enclosing the sides and top of the cooler tank; the whole being mounted on proper supports, substantially
19 as described and for the purposes set forth.

HOYT H. WHEELER.
K. HASKINS,
Solicitor.

And afterwards, and on the 12th day of April, A. D. 1884, a notice and motion for rehearing in said cause was filed, which said notice and motion are in the words and figures following:

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, March 8, 1884.

MR. W. E. SIMONDS,
No. 1 *Central Row, Hartford, Conn.:*

SIR: You are hereby notified that on Monday, the 17th instant, at 10 o'clock a. m., or as soon thereafter as counsel may be heard, I shall move for rehearing in the cause entitled, Samuel Hill, Benjamin B. 20 Prentice, and the Vermont Farm Machine Co. vs. The Commissioner of Patents, in equity, and would suggest to you that if it meets your approval said motion may be heard before Hon. Hoyt Wheeler, in the city of New York, at that time. This will be more convenient to the office than a hearing in Vermont, and will be probably be as convenient to you.

Please accept service of the inclosed motion, and return the same, together with a letter indicating whether the place for argument above suggested meets with your approval.

Very respectfully,

FRANK T. BROWN,
Att'y for Commissioner of Patents.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, March 8, 1884.

United States circuit court, district of Vermont.

21 SAMUEL HILL, BENJAMIN B. PRENTICE, and the Vermont Farm Machine Co., *vs.* THE COMMISSIONER OF PATENTS. } In equity.

And now comes Benj. Butterworth, Commissioner of Patents, by his attorney, Frank T. Brown, and moves that the decree of the court filed February 9th, 1884, may be set aside, and a rehearing granted in the above-entitled cause.

An in support of this petition your petitioner showeth that in view of sections 738, 739, 740, and 4915, R. S., and the judicial interpretation thereof, it is respectfully urged that this court has no jurisdiction in the above-entitled cause; and for the further reason your petitioner showeth that at the time of the receipt of the copy of the bill of complaint (October 18, 1883) the office of Commissioner of Patents was held by the Hon. E. M. Marble, but his resignation had previously (October 10, 1883) 22 been tendered and he had been notified that it would be accepted, to take effect shortly thereafter. Again, at this time the position of law clerk of the Patent Office was vacant, and as this is the officer usually designated to defend causes on appeal from the decision of the Patent Office, the circumstance prevented any appearance of the defendant, the Commissioner of Patents, in said cause; and thereupon Mr. Marble notified Mr. Simonds, the counsel for the complainants, under date of October 18, 1883, that he should "not appear in defense of said bill." The cause therefore proceeded ex parte, and a decree was rendered February 9, 1884, which in effect reversed the ruling of the Patent Office.

It is believed that the decision of the honorable court is based upon an erroneous view of the law, as announced in prior decisions of the courts, and would be changed or modified after a full argument of the case upon both sides.

23 As the decision heretofore rendered is in conflict with the established practice of the Patent Office, and the decisions of the courts, heretofore made, as interpreted by such office, cannot be corrected by appeal, and was rendered without an argument on both sides, it is hoped that the honorable court will set aside the decree, filed February 9, 1884, and granted a rehearing upon such day as will suit its convenience.

FRANK T. BROWN,
Att'y for Commissioner of Patents.

Service of the within motion and notice is hereby acknowledged.

W. E. SIMONDS,
Att'y for Hill & Prentice et al.

HARTFORD CONN., *March* 10, 1884.

P. S.—The time & place herein indicated for hearing this motion are acceptable to me.

W. E. SIMONDS,
Att'y, &c.

24 And afterwards, and during the February term, A. D. 1884 of this court, said motion for rehearing came on for hearing before the honorable Hoyt H. Wheeler, district judge of the United States within and for the district of Vermont, sitting in equity.

And afterwards, and on the 12th day of April, A. D. 1884, a decision denying said motion for rehearing, was filed, which decision is in the words and figures following:

Circuit court of the United States, district of Vermont.

VERMONT FARM MACHINE CO. AND OTHERS
vs.
E. M. MARBLE, COMMISSIONER OF PATENTS.
} In equity.

WHEELER, *J.* The bill was brought for an adjudication that the orators were entitled to a patent, pursuant to section 4915, Rev. Stat. 25 The defendant accepted service of the subpœna, to have the same effect as if duly served on him by a proper officer, and acknowledged receipt of a copy, but did not appear in court, nor made any objection to proceeding to decree. After hearing the orators a decree was made and entered in their favor. (19 Fed. Rep., 307.) The present Commissioner now moves for a rehearing, principally upon the ground of alleged want of jurisdiction of this court. One mode of attempting to show that this court has not jurisdiction is by claiming that the supreme court of the District of Columbia has exclusive jurisdiction. The language of this section, however, seems to preclude this idea. It reads: "Whenever a patent, on application, is refused, either by the Commissioner of Patents, or by the supreme court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity."

This seems to clearly imply that the remedy may be elsewhere. (Whipple v. Miner, 15 Fed. Rep., 117.) Another and the principal mode 26 is by claiming that no circuit court of a district away from the Patent Office and in which the Commissioner does not reside can acquire jurisdiction of such cases. The circuit courts have original jurisdiction (ninth) of all suits at law or in equity arising under the patent or copyright laws of the United States. (Rev. Stat., § 629.) This is unquestionably a suit so arising. There is no restriction upon proceeding in these courts in such cases, except that civil suits against inhabitants of the United States are not to be brought by original process in any other district than that in which the defendant resides or is found at the time of service. (Id., § 639.) The court had general jurisdiction of this subject, and the defendant, by his acceptance of service, consented to be found in this district, and did not appear in court to object to being bound by this consent.

In ex parte Schollenberger (96 U. S., 369) Mr. Chief Justice Waite, in delivering the opinion of the court, says:

"The act of Congress prescribing the place where a person may
27 be sued is not one affecting the general jurisdiction of the courts.
It is rather in the nature of a personal exemption in favor of a defendant, and one which he may waive. If the citizenship of the parties is sufficient a defendant may consent to be sued anywhere he pleases, and certainly jurisdiction will not be ousted because he has consented."

Here no question was made before. Now, where one on this subject is made it is not whether the commissioner can be compelled to answer, but whether he can consent to be sued away from the seat of government and his residence. Prentiss v. Ellsworth, Mirror of Pat. Off., 35; Laws Dig., 103; Whart. Dig., 365, raised the question as to the compulsion, and not as to the consent, and it was held, upon apparently sound reasoning, by Randall, *J.*, that the Commissioner could not be compelled, by process issuing out of the circuit court for the eastern district of Pennsylvania, to answer there. The question of jurisdiction founded on consent did not
arise. It is further objected against the jurisdiction here that the
28 court here could not compel obedience of the Commissioner at the
Patent Office to its decree. It is to be presumed, however, that a high officer of a department of the Government will do his duty without compulsion, or even command, from any quarter, especially in a matter where he has no interest, nor the Government any, except that the duty be done. This provision of the statute is framed according to this view. The court does not decree that the Commissioner shall issue a patent, but only "may adjudge that such applicant is entitled according to law to receive a patent for his invention as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent," etc. Granting the permissson expressed the will of Congress, which would be sufficient? Neither the adjudication nor issuing the patent under it will conclude any individual rights. The validity
of the patent will be open to trial under the law. But if the pat-
29 ent is not granted no suit for infringement can be brought, and the
right to the invention cannot be judicially tested. This jurisdiction has been exercised without challenge, except in Prentiss vs. Ellsworth, supra, Ellithorpe v. Robertson, 2 Fish., 83. As this case is now considered, the jurisdiction upon the consent of the Commissioner seems to be ample. The question involved in the case on the merits was purely one of law, requiring the production of no models or exhibits, and no personal

attendance, and might well be submitted anywhere. Whether, under the circumstances, it should be submitted here rested in the discretion of the Commissioner. His act, in this respect, is binding upon his successor, like any other lawful act, and it oppresses no one. This ground presents no reason that appears to be sufficient for opening the case. All the grounds now urged on the merits of the application for the patent were fully considered before, and no sufficient reason appears for going over the ground again.

The motion is denied.

30 And afterwards the defendant and appellant filed his petition for appeal of said cause to the Supreme Court of the United States, which said petition and prayer for appeal was duly allowed and ordered to be filed and was filed on the 21st day of July, A. D. 1884; which said petition for appeal and order are in the words and figures following:

In the circuit court of the United States, district of Vermont.

THE COMMISSIONER OF PATENTS OF THE UNITED States of America, defendant and appellant,
vs.
SAMUEL HILL, BENJAMIN B. PRENTICE, AND the Vermont Farm Machine Company, complainants and appellees.
} In equity.

To the honorable the Supreme Court of the United States:

The appeal of Benjamin Butterworth, the Commissioner of Patents
31 of the United States of America, the above-named defendant and appellant, respectfully showeth:

That on the 12th day of October, A. D. 1883, the above-named complainants filed their bill in the circuit court of the United States for the district of Vermont against the Commissioner of Patents of the United States of America (to wit, E. M. Marble), charging that prior to March 30, 1880, the said Samuel Hill and Benjamin B. Prentice were the original, first, and joint inventors of a certain new and useful and patentable improvement in a milk-setting apparatus, which said invention never was abandoned by them, and was not in public use or on sale for more than two years prior to their application for letters patent therefor; that on or about said 30th day of March, 1880, the said Hill and Prentice filed in the Patent Office of the United States their application for letters patent upon said improvement or invention, which said application is still pending therein; that, as a part of said application and specification of
32 said invention, the said Hill and Prentice made nine different claims, or clauses of claim, of invention, and are numbered from one to nine, inclusive; that the first four of said claims, so numbered as aforesaid, were rejected by the said Commissioner of Patents on the ground that the subject-matter thereof is shown and described, but not claimed, in a prior patent for milk-setting apparatus granted to said Hill and Prentice, No. 207738, and dated September 3d, 1878; that said letters patent No. 207738, with the rights and privileges granted and secured thereby, were duly conveyed to the said Vermont Farm Machine Company by the said Hill and Prentice April 3d, 1879, and was duly recorded in the Patent Office; that the invention forming the subject-matter of said pend-

ing application, and all rights to letters patent therefor, were also duly conveyed to the said Vermont Farm Machine Company by the said Hill and Prentice September 12th, 1881, and was duly recorded in said Patent Office; and further charging that the decision of the said
33 Commissioner of Patents refusing the grant of letters patent containing said first four claims, or clauses of claim, of invention is unlawful and wrongful, and praying that the said court adjudge and decree that said Hill and Prentice, as inventors, and said Vermont Farm Machine Company, as the assignees of said inventors, are entitled by law to have and receive letters patent therefor, and for other and further relief, &c.

The usual writ of subpœna was duly issued October 12, 1883, directed to the Commissioner of Patents of the United States of America, commanding him to appear before the judges of the circuit court of the United States for the district of Vermont, at Burlington, in said district, November 5, 1883, at 10 o'clock a. m., to answer to the aforesaid bill of complaint; which said subpœna was duly returned into court, with the service thereof accepted by the said E. M. Marble, then Commissioner of Patents. The aforesaid bill and subpœna are referred to and made a part hereof.

34 No appearance was made by the said Commissioner of Patents or entered in his behalf, and said cause came on for hearing before the said circuit court of the United States at an adjourned session of the October term thereof, held at Rutland, in said district of Vermont, December 4th, 1883, and thereupon a decree was entered in favor of said complainants, adjudging that they were entitled to have and receive letters patent for the invention covered by their said first four claims of their said application; which said decree was duly filed in the office of the clerk of said court February 9, 1884.

March 8, 1884, your petitioner, Benjaman Butterworth, Commissioner of Patents, and successor to the said E. M. Marble, made and entered in said court his motion to set aside the aforesaid decree of Feb'y 9, 1884, and that a rehearing be granted in said cause for the reasons therein set forth. Said motion is referred to and made a part hereof.

35 Said motion came on to be heard March 17, 1884, and thereupon after hearing, the motion of your said petitioner was denied.

Therefore the said appellant appeals from said decree of said circuit court of the United States, and the further decision and decree of said denying said motion to set aside said decree, and for a rehearing of said cause for the reasons set forth in said motion; and respectfully prays that said bill of complaint, subpœna, motion, evidence, exhibits, decree, and all the proceedings in said cause may be sent to the Supreme Court of the United States without delay, and that said Supreme Court will proceed to hear said cause anew, and that the decree of said circuit court may be reversed, and a decree dismissing said bill with costs, or such other decree be made in said cause as to the said Supreme Court shall seem just.

BENJ. BUTTERWORTH,
Com'r of Patents.

36 The foregoing petition and prayer for an appeal allowed, and ordered on file this 21st day of July, A. D. 1884.

HOYT H. WHEELER.

And on the same 21st day of July, A. D. 1884, a citation was duly issued out of this court, which citation is hereto annexed; and the same was returned into this court, with service duly accepted, in writing thereon on the 26th day of August, A. D. 1884.

37 UNITED STATES OF AMERICA,
District of Vermont, ss:

By the honorable Hoyet H. Wheeler, district judge of the United States for the district of Vermont, and judge of the circuit court of the United States for said district of Vermont, in the second circuit, to Samuel Hill, of Greensboro', in the county of Caledonia, Benjamin B. Prentice, of Hardwick, in the county of Caledonia, and the Vermont Farm Machine Company, a lawful corporation, located and doing business at Bellows Falls, in the town of Rockingham, in the county of Windham, and all of the State and district of Vermont greeting:

Whereas Benjamin Butterworth, Commissioner of Patents of the United States of America, has lately appealed to the Supreme Court of the United States from a decree lately rendered in the circuit court of the United States for the district of Vermont, in favor of you, the said Samuel Hill, Benjamin B. Prentice, and the Vermont Farm Machine Company, you are, therefore, hereby cited to appear before the Supreme Court of the United States, at the term of said court next to be holden at the city of Washington, on the first day of said term, to wit, on the second Monday of October, A. D. 1884, then and there to do and receive what may appertain to law and justice in the premises.

And it is further ordered that a true and attested copy of this citation be served by the marshal for the district of Vermont upon each of said appellees at least thirty days before said second Monday of October, A. D. 1884.

Done at chambers at Brattleboro', in said district of Vermont, in the second judicial circuit, this 21st day of July, A. D. 1884.

HOYT H. WHEELER.

38 BRATTLEBORO, VT., *August 26th*, 1884.

In behalf of the appellees, Samuel Hill, Benjamin B. Prentice, and the Vermont Farm Machine Company within named, I do hereby accept service of this citation; said acceptance to have the same legal effect as though regularly served upon each one thereof, as within commended.

KITTREDGE HASKINS,
Solicitor for said Appellees.

(Indorsed:) Commissioner of Patents, appellant, vs. Samuel Hill, Benjamin B. Prentice, and Vermont Farm Machine Company, appellees. U. S. circuit court, district of Vermont. In equity. Citation. Returned service accepted, August 26th, 1884. Geo. E. Johnson, deputy clerk.

39 UNINED STATES OF AMERICA,
District of Vermont, ss:

I, Geo. E. Johnson, deputy clerk of the circuit court of the United States of America for the district of Vermont, in the second circuit, do hereby certify that the foregoing pages, numbered from 1 to 38, inclusive, contain a true and complete transcript of the records and proceedings had in said court in the case of Samuel Hill, Benjamin B. Prentice, and the Vermont Farm Machine Company, orators and appellees, against the Commissioner of Patents of the United States of America, defendant and appellant, as the same remains of record and on file in said office.

In testimony whereof, I have caused the seal of said court to be hereunto affixed, at the city of Burlington, in the district of Vermont, in the second circuit, this 30th day of September, A. D. 1884, and of the Independence of the United States the one hundred and ninth.

[SEAL.] GEO. E. JOHNSON,
Deputy Clerk.

(Indorsement on cover:) No. 1044. Benjamin Butterworth, Commissioner of Patents of the United States, appellant, vs. Samuel Hill, Benjamin B. Prentice, and the Vermont Farm Machine Company. Vermont C. C. U. S. Filed 10' October, 1884.

114-128

In the Supreme Court of the United States.

OCTOBER TERM, 1884.

BUTTERWORTH, COMMISSIONER, &c.,
v.
HILL AND OTHERS.
No. 1044.

BRIEF FOR THE UNITED STATES.

In the Supreme Court of the United States.

OCTOBER TERM, 1884.

BUTTERWORTH, COMMISSIONER, &C.,
v.
HILL AND OTHERS.
} No. 1044.

BRIEF FOR THE UNITED STATES.

This is an appeal taken by the present Commissioner of Patents from a decree of the circuit court of Vermont in a case authorized by Revised Statutes, sec. 4915 (below), in which the subpœna had been served upon the Commissioner's predecessor, during *his* term of office.

In March, 1880, the appellees had applied to Mr. Marble, then Commissioner, for letters patent upon an improvement in "milk-setting apparatus," and had been denied; thereupon, in September, 1883, they had filed a bill in equity in the circuit court for Vermont (under sec. 4915), praying to have such letters issued, &c., and in the mean time for a subpœna to the Commissioner, &c. The subpœna having been served, Mr. Marble gave notice that he could not appear. Thereupon a decree was made as prayed for.

In April, 1884, the present Commissioner moved for a rehearing, and this having been refused he appealed.

The statutory provisions relevant to the question are as follows:

Rev. Stat.:

> SEC. 4911. If such party [applicant for letters patent], except a party to an interference, is dissatisfied with the decision of the Commissioner he may appeal to the supreme court of the District of Columbia, sitting in banc.
>
> SEC. 4912. When an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.
>
> SEC. 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.
>
> SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence pro-

> duced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.
>
> SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled according to law, to receive a patent for his invention as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. [See sec. 629, par. 9.]

The question which the Patent Office desires to present upon this appeal is whether section 4915 confers the jurisdiction therein spoken of upon any other court of equity than that of the District of Columbia.

For error therefore is assigned, the action of the court below in taking jurisdiction of the present case, being an application in equity for letters patent under section 4915.

1. As preliminary, it is submitted that under section 4915 the Commissioner becomes *a party to the suit*, at the same time being expressly shielded from costs by virtue of the last clause.

The "appeal" under sections 4911 to 4914, inclusive, is of a quasi *executive* (a mingled) character, having the same effect as in the sections immediately previous, where it denotes the steps taken for review within the Patent Office itself: from examiners to the examiner-in-chief, and then from him to the Commissioner. The proceedings are "summary." It may be conceded that no appeal or writ of error would lie from the decisions therein.

Under 4915, however, the proceedings are to be regular, and the method by which defendants in equity suits are ordinarily called in is that which is employed to bring in the Commissioner; and that whether the previous *decision* to be questioned thereby be one by the Commissioner, or one by the supreme court of the District upon appeal to it from a decision by the Commissioner.

If a party, he may avail himself of the principle in the case United States *v.* The Circuit Judges (3 Wall., 673) and claim that although no right of appeal be given expressly by 4915, yet such right arises necessarily out of the circumstances, viz, that the case is one assigned to the regular routine of a subordinate court of equity, its subject-matter being somewhat *amphibious* (betwixt the *executive* and the *judicial* order), but, as such, one which, according to the discussion in Murray *v.* Hoboken, 18 Haw., 272, may, at the will of the legislature, at several stages of the proceeding thereabouts be one while completely *executive*, and another while completely *judicial* in its nature.

The Commissioner therefore may avail himself of the provisions of Revised Statutes, section 699, and appeal from the decree below as being a final decree in a "case touching patent rights."

2. It is further submitted that the connection of the Commissioner of Patents with the suit spoken of in section 4915 does not subject the present appeal to objections which apply to cases of mandamus upon a devolution of office pending suit, as in Boutwell's case, 17 Wall., 604; for here it is not the *officer* so much as the *office* that is to be bound by the decree; the decree is to operate upon official *discretion*, and not upon a ministerial disobedience personal to the officer, and, besides, there is no liability by the defendant in respect of *costs*.

The Commissioner who is in office when suit is brought may not be the one who gave the decision objected to; a circumstance which shows, by analogy, that his appearance is in behalf the office in general; a *quasi* corporate appearance as "*Commissioner*," and not as "*E. M. Marble*."

3. Assuming, then, that the Commissioner is a party, and that the present appeal has been properly taken, it is

submitted in terms of the above assignment of error that the jurisdiction conferred by section 4915 is conferred upon the court of equity for the District of Columbia only, and so that the court below was without jurisdiction.

This objection is made by the Patent Office in no captious or inconsiderate temper, but solely under an impression of the vast inconvenience to important public interests which is threatened by the ruling objected to. In view of the enormous business of the office, and the widely spread residences of applicants therein, it may reasonably be anticipated that, under the ruling below, the Commissioner in no long time will be called upon to give attention to similar suits in equity pending concurrently in every State and Territory of the Union, and, thereupon, to remove hither and thither, for the information of the respective courts, valuable models and other exhibits belonging to his office.

For an argument upon the statutory question involved in this point I content myself with referring to the special brief filed in the present case by an officer of the Patent Office.

In the same connection is appended below a report of the case Prentiss *v.* Ellswater, Conner, &c. (eastern district of Pa., April 11, 1846), taken from the Official Gazette of the Patent Office May 6, 1884. This has been followed since, as I am credibly informed, in several other cases in various districts.

S. F. PHILLIPS,
Solicitor-General.

APPENDIX.

1. When the sections of the statute are construed together, it is held that when there are two interfering patents the circuit court of the district whereof the defendant is an inhabitant or where he may be found is the court "having cognizance," and where an original application for a patent has been refused and a remedy is sought in equity, and the process is to be served on the Commissioner of Patents, then the circuit court of the District of Columbia is the proper tribunal to entertain the suit.
2. An objection to the jurisdiction of the circuit court in Pennsylvania is that it has no mode of enforcing obedience to its decree, since the circuit courts outside of the District of Columbia have no authority to issue a writ of mandamus to an officer of the United States commanding him to do a ministerial act.

STATEMENT OF THE CASE.

The complainant filed his bill complaining that the defendant as Commissioner of Patents had refused to grant him a patent for certain improvements made by him in the art of weaving goods of various kinds, and prayed the court should by decree order the letters patent prayed to be issued. The defendant filed a plea to the jurisdiction and a general demurrer to the bill. Mr. B. H. Brewster, for Commissioner of Patents, maintained that the court has no jurisdiction; that the defendant did not reside and was not within its jurisdiction at the time process issued (Act of Congress, sec. 11, 1839). The only court that can have jurisdiction at any stage of proceedings to obtain a patent is the circuit court of the District of Columbia (Acts of 1801 and 1815, 4 Cranch, 421; 5 Cranch, 288; 8 Wheaton, 699; 7 Cranch, 202; 1 Peters, C. C. R., 489). Unless the court has jurisdiction under the patent laws or by some other act of Congress, the bill must be dismissed (5 Cranch, 173; 1 Wash., 232; 4 Dallas, 7).

The patent laws contain no provision investing the circuit courts with such authority. The policy of the law is against the exercise of this authority. The Commissioner would be exposed to endless trouble and inconvenience. He would be compelled to answer at the same time at different points of the Union, and, if the prayer of the bill were granted, to carry with him the models, books, papers, and documents that are of record in the office at Washington, when thereby the public interests would require them to be in the custody of the Department at the seat of Government (2 Kent, 355 to 372; Phillips on Patents, 313, 57, 379). The law furnishes a remedy for the errors of a hasty examination of an application for a patent (Sec. 7 of act of 1836.) The complainant must strictly conform to the provisions of that act before he can apply for the intervention of a court of equity, even had this court jurisdiction, and he must aver in his bill that he has conformed to the provisions of the law. That he has not done. The bill does not state that he has complied with the provisions of the act of 1839 (Peters, C. C. R., 356; 3 Howard, 441). The Commissioner of Patents is the judge created by law to decide upon these questions. To him must application be made and renewed after a certain formal method laid down in the act, and this court could not now assume to decide the question even had it concurrent jurisdiction, much less when the exclusive jurisdiction is vested in the Commissioner (9 Wheaton, 532; 1 Paine, 620). This court has no power to enjoin or command an officer of the General Government residing at Washington to perform any act. How, then, could it enforce its decree? (1 Kent, 322; 3 Dallas, 42; 9 Peters, 574, 602; 8 Peters, 306; 12 Peters, 524; 13 Peters, 279; 7 Peters, 634; 7 Cranch, 577.)

Mr. Waln, in reply, said:

> If the court has no jurisdiction, then the party aggrieved is without remedy. The argument *ab in convenienti* can never be urged to deprive man of his

rights and all legal protection. The jurisdiction is expressly given by the sixteenth section of the act of 1836, and tenth section of the act of 1839. The law provides that expenses shall be paid by complainant in contemplation of the inconvenience to which the Commissioner might be subjected in complaints like this. If parties are confined to the courts of the District of Columbia, then they could not have the decrees of the courts enforced in any other part of the United States except in their local jurisdiction. It is a narrow construction of the law to oust the jurisdiction.

RANDALL, *J.:*

The bill in this case charges that on or about the 8th day of March, 1843, the complainant entered a caveat in the Patent Office of the United States describing certain improvements made by him in the art of weaving, and that on or about the 8th day of August, 1844, he referred his petition to the Commissioner of Patents, wherein he represented that he had invented certain new and useful improvements in the apparatus for weaving goods of various kinds, and did therein claim as new, as specified in the bill. The bill further charged that the complainant, having in all things complied with the terms and conditions of the act of Congress in such cases made, having furnished specifications, drawings, and models, and paid into the Treasury the legal fee, he did pray that letters patent of the United States might be granted, vesting in him and his legal representatives the exclusive right to the said invention, &c., and that the Commissioner, intending, &c., absolutely refuses to comply with the said reasonable request. After stating the formal excuses or pretenses and propounding certain interrogatories, the orator prays that a copy of the bill may be served on the Commissioner of Patents, and that he may be required to answer, to produce the specification, model, drawing, and submitted in terms of the above assignment of error that the jurisdiction conferred by section 4915 is conferred upon the court of equity for the District of Columbia only, and so that the court below was without jurisdiction.

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By the seventh section of the act of 1836 it is enacted—

> That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made an examination of the alleged new invention or discovery; and if on any such examination it shall not appear to the Commissioner that the same has been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever on such examination it shall appear to the Commissioner that the applicant was not the original

and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him briefly such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the Treasurer for paying back to the said applicant the said sum of twenty dollars; but if the applicant in such case shall persist in his claim for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew in manner as aforesaid; and if the specification and claim shall not have been so modified as in the opinion of the Commissioner shall entitle the applicant to a patent, he may, on appeal and upon request in writing, have the decision of a Board of Examiners, to be composed of three disinterested persons, who shall be appointed for that purpose, by the Secretary of State, one of whom at least to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains, who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said Board shall be furnished with a certificate in writing of the opinion and de-

> cision of the Commissioner, stating the particular grounds of his objection and the part or parts of the invention which he considers as not entitled to be patented; and the said Board shall give reasonable notice to the applicant as well as to the Commissioner of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the Board of Examiners such information as he may possess relative to the matter under their consideration; and on an examination and consideration of the matter by such Board it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part; and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided, however*, That, before a Board shall be instituted in any such case the applicant shall pay to the credit of the Treasury, as provided in the ninth section of this act, the sum of twenty-five dollars; and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out any moneys in his hands, which shall be in full compensation to the persons who may be so appointed for their examination and certificate as aforesaid.

The eighth section provides—

> That whenever an application shall be made for a a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to

> such applicant or patentee, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner in the question of priority of right or invention, he may appeal from such decision on the like terms and conditions as are provided in the preceding section.

The sixteenth section then enacts—

> That whenever there shall be two interfering patents, or whenever a patent or application shall have been refused on an adverse decision of a Board of Examiners, on the ground that the patent applied for would *interfere* with *an unexpired patent previously granted*, any person interested in any such patent, either by assignment or otherwise in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge and declare *either* the patents void in the whole or in part or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear; and such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent on his filing a copy of the adjudication and otherwise complying with the requisitions of this act: *Provided, however*, That no such judgment or adjudication shall affect the rights of any person, except the parties to the action and those deriving title from or under them subject to the rendition of such judgment.

This section gives the remedy by bill in equity to those cases only provided for by the eighth section of this act; but by the tenth section of the act of 1839 it is declared—

> That the provisions of the sixteenth section of the before-recited act shall extend *to all cases where patents are refused for any reasons whatever*, either by the Commissioner of Patents or by the chief justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of or by reason of interference with a previously-existing patent; and in all cases where there is no opposing party a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

The effect of this section is to give to all persons whose applications are refused under the seventh section (and who were concluded by the decision of the Board of Commissioners under the act of 1836) the same remedy as was provided for those who came within the provision of the eighth section. The remedy is by bill in equity in the court *having cognizance thereof.*

On the part of the complainant it is contended that inasmuch as the seventeenth section of the act of 1836 declares—

> That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable as well in equity as at law by the circuit courts of the United States, or any district court *having the powers and jurisdiction of a circuit court*—

that Congress did not intend to give jurisdiction to the courts of the District of Columbia, where there is no district court *having the power of a circuit court*, but to the courts of the United States established by the judiciary act of 1789, and the complainant being a resident here this court has the jursidiction.

In the construction of statutes every part of the act and acts in *pari materia* are to be taken together for the purpose of discovering the intention of the legislature, which, when ascertained, is to prevail. It shall be so construed, if possible, that no clause, sentence, or word shall be rendered superfluous or void; and when great inconvenience will result from a particular construction, that construction shall be avoided, unless the meaning of the legislature be plain, in which case it must be obeyed (2 Cranch, 386).

With these rules in view, let us examine the question presented for consideration.

By the section of the act of September 24, 1789, establishing the judicial courts of the United States, it is enacted—

> That no person shall be arrested in one district for trial in another in a civil action before a circuit or district court, and no civil suit or action shall be brought before either of the said courts against an inhabitant of the United States by any original process in any other district than that *whereof he is an inhabitant or in which he shall be found* at the time of serving the writ.

The third section of the act of February 27, 1801, concerning the District of Columbia (3 Story, 2089, appendix), declares—

> There shall be a court in the said District, which shall be called the "circuit court of the District of Columbia;" and the said court and the judges thereof shall have all the power by law vested in the circuit courts and the judges of the circuit courts of the United States.

And by the fifth section—

> The said court shall have cognizance of all cases in law and equity between parties both or either of whom shall be a resident or found within said District.

The fourth section of the act of March 3, 1815, vesting more effectually jurisdiction in State courts (2 Story, 1531), enacts—

> That the district courts of the United States shall have cognizance concurrent with the courts and magistrates of the several States and the circuit courts of the United States of all suits at common law when the United States or any officer thereof, under the authority of an act of Congress shall sue, although the debt, claim, or other matter in dispute shall not amount to one hundred dollars.

Various other statutes have been passed either imposing penalties or providing relief, in which it is said the district or circuit courts of the United States shall have jurisdiction; but in all such cases it is understood the intention of Congress was to give jurisdiction to those courts according to well known and settled principles. These principles are, that process for the institution of a suit either at law or equity in the district or circuit courts shall not run beyond the limits of the district for which the court from which it issues is held, and that the circuit court of the District of Columbia has full equity powers where both or either of the parties shall be found within that jurisdiction. The prohibition of the service of process out of the jurisdiction is, however, a personal privilege which may be waived; but in the present case the defendant has availed himself of the first opportunity to make the objections.

Another objection to the jurisdiction of this court is the mode of enforcing obedience to its decree. It is to be presumed that a court will not take cognizance of a cause unless it can execute its judgment. Now, if this court should take jurisdiction of the complainant's bill and decide that he is entitled to a patent, how can that decision be enforced if the Commissioner should refuse to issue the patent? The proper remedy would seem to be by a mandamus; but the Supreme Court have decided that the circuit courts out of the District of Columbia have no authority to issue a writ of mandamus to an officer of the United States commanding him to do a ministerial act, but that the circuit court for the District of Columbia has such power (Kendall *v.* United States, 12 Peters, 525). In every aspect of the case it appears to me that this court has no jurisdiction of the complaint. By this construction full effect may be given to every word of the section under consideration: Where there are two interfering patents, the circuit court of the district, whereof the defendant is an inhabitant or where he may be found, is the court "having cognizance," when an original application for a patent has been refused and there is no opposing party, so that the process, a copy of which is to be served on the Commissioner of Patents, the circuit court of the District of Columbia, of which the Commissioner is an inhabitant, and which can enforce its judgment, is the proper tribunal. This view also avoids the great inconvenience which would result from the construction contended for by the counsel for the complainant.

The bill prays that the Commissioner be required to produce on the hearing the specifications, models, drawings, &c., and these may be necessary to enable the court to determine upon the validity of the application for a patent. If the Commissioner can be required to produce these in this court, he may with as much propriety be called on to answer similar applications in any circuit court of the Union; an inconvenience, to say the least of it, which, if it had been intended by Congress, they would have used plain, precise, and clear language, such as would not leave the intention open to judicial construction or leave it liable to be misunderstood. This view renders it unnecessary to consider the argument urged in support of the demurrer.

The plea to the jurisdiction is sustained, and the bill dismissed for want of jurisdiction.

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Office Supreme Court U. S.
FILED.
JAN 19 1885
JAMES. H. McKENNEY,
CLERK.

Supreme Court of the United States,
OCTOBER TERM, 1884.

BENJAMIN BUTTERWORTH,
Commissioner of Patents, Appellant,

VERSUS

HILL & PRENTICE AND THE VERMONT FARM MACHINE COMPANY, APPELLEES.

IN EQUITY, No. 1,044.

Appeal from the Circuit Court of the United States for the Second Circuit and District of Vermont.

SUPPLEMENTAL BRIEF FOR APPELLANT.

FRANK T. BROWN,
Of Counsel.

WASHINGTON:
GOVERNMENT PRINTING OFFICE.
1885.

Before the Supreme Court of the United States.

SUPPLEMENTAL BRIEF FOR APPELLANT.

MAY IT PLEASE THE COURT:

As has already been stated, the bill, serving as the foundation of this suit, was brought to review the action of the Commissioner of Patents refusing to grant a patent to the defendants in error on account of the existence of a statutory obstacle. The bill was supposed to be authorized by section 4915 R. S., which is as follows:

"Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having *cognizance* thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

The first point to be considered is whether the court below had jurisdiction. It is argued that as a regular appeal to the Supreme Court of the District of Columbia is allowed by other sections of the statutes, and section 4915 permits the filing of a bill in equity in the court having cognizance thereof, even after a patent is refused on appeal by the Supreme Court of the District of Columbia, it was the intention of the legislature to permit a review of the decision of said court by some other court of the United States. This view might be formed from a hasty reading of the sections above referred to, but will be found erroneous upon a careful examination of them in connection with other sections in *pari materia.*

Section 4909 provides that—

"Every applicant for a patent, or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal."

Section 4910 provides that—

"If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person."

Section 4911 is as follows:

"If such party, *except a party to an interference*, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia sitting in banc."

Section 4914 enacts—

"The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, *on the evidence produced before the Commissioner*, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal." * * * * * * *

A comparison of the sections just quoted, by means of which an *appeal* may be taken in certain cases to the Supreme Court of the District of Columbia, with the section first quoted, providing for a remedy by a bill in equity, will show that the purpose of the legislature in enacting section 4915 was to supplement the legal remedy by one more far-reaching, and thus to afford complete relief to a party who supposed himself to be aggrieved. Under the sections of the law providing for an appeal to the Supreme Court of the District of Columbia, interference cases were expressly excepted, so that a party against whom the Commissioner rendered a judgment in an interference case could not appeal therefrom. But here section 4915 came into play, and in effect said the party shall not go remediless, for though there is no remedy at law, yet the whole matter of right between the contestants may be inquired into by a bill in equity.

Again, the jurisdiction of the Supreme Court of the District of Columbia under the other sections is strictly appellate, for section 4914 expressly says: "The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, *on the evidence produced before the Commissioner*, * * * *and the revision shall be confined to the points set forth in the reasons of appeal.*"

It follows, therefore, if important facts favorable to the applicant's case were by inadvertence, or otherwise, not presented to the Commissioner, the Supreme Court of the District, under sections 4911 to 4914, could not examine them, nor do anything in the premises except revise the decision of the Commissioner on the evidence *before him*. If then the Supreme Court of the District of Columbia found that the Commissioner decided justly on the evidence before him, and the Commissioner refused to receive any more evidence, the applicant would be remediless, even though he was justly entitled to a patent; but section 4915 again supplements the sections of the statutes, above referred to, to the extent of affording a separate and independent proceeding for the trial of the rights of the applicant. It gives the opportunity for a judicial inquiry into the entire case by a bill in equity. The instances above mentioned afford an illustration of the different classes of cases reached respectively by the strictly appellate proceedings, and the original proceedings by bill in equity, and indicate the purpose of the legislature in enacting the several sections referred to.

In the Revised Statutes of the United States relating to the District of Columbia, post roads, and public treaties, the following provisions are found:

"Section 750. There shall be a Supreme Court of the District, which shall consist of a chief justice and four associate justices, who shall severally be appointed by the President, by and with the advice and consent of the Senate, and shall hold their offices during good behavior."

"Section 760. The Supreme Court shall possess the same powers, and exercise the same jurisdiction as the circuit courts of the United States."

It therefore, appears, that the Supreme Court of the District of Columbia have the powers of any circuit court. Indeed, I may say they have jurisdiction of causes of greater national interest than any other court of original jurisdiction in the land. Yet we look in vain for any distrust manifested by the legislature of their ability to administer justice as accurately and impartially as any other original court of the country. They are empowered by law to try causes relating to the infringement of patents, trade-marks, &c., and the only review of their decision on these matters which can be had is through the Supreme Court of the United States, the head of the entire Federal judiciary. And yet it is urged that section 4915, R. S., contemplates the anomaly of giving the power of a review of the decision of the Supreme Court of the District to some other circuit. Why should Congress single out the particular class of cases now under discussion for revision by some other court? Why should Congress select the circuit court denominated the Supreme Court of the District of Columbia, and say to them alone that their decisions shall be reviewable by any court of equal rank in the United States? Is it not highly improbable that section 4915, R. S., contemplates any such thing?

When analyzed in this manner, it will be seen that there is no inconsistency in construing section 4915 so as to confine the jurisdiction of bills in equity, in which the Commissioner of Patents is made a party, to the Supreme Court of the District of Columbia.

If a court other than the Supreme Court of the District of Columbia should take jurisdiction in a suit against the Commissioner of Patents, and should enter a decree against him, holding that a patent should issue as prayed for by the relators, how could such decree be enforced? The ordinary way of enforcing a decree is by a mandamus, but the Supreme Court of the United States have repeatedly held that the circuit courts out of the District of Columbia, have no authority to issue a writ of mandamus to an officer of the United States commanding him to do a ministerial act. (See Cendall *v.* United States, 12 Peters, 525; Wood *v.* McIntyre, 7 Cranch, 504; and McClung *v.* Sullivan, 6 Wheat., 498.) And it is not to be presumed that a court will take jurisdiction of a case unless it can execute its judgment.

Furthermore, consider the inconvenience which would be entailed upon the Commissioner of Patents if every dissatisfied applicant for a patent could elect a tribunal and compel the Commissioner to defend the cause or else allow it to go by default. The Commissioner, under such a construction of the statute, might be called upon to defend suits in Maine, Mississippi, and California, and to produce papers, models, &c., at these remote places; and when great inconvenience will result from a particular construction, such construction should be avoided unless the legislature plainly intends it. (See 2 Cranch, 386.)

From the foregoing it appears that sections 4911, 4914, and 4915 may be construed so as to permit the bringing of a bill in equity for reviewing the decision of the Commissioner and of the Supreme Court of the District of Columbia *on appeal* from him, only in the Courts of said District; that such a construction gives force and effect to every sentence or word in said section, and is the only reasonable one, for by any other great inconvenience would result to the Commissioner, and the anomaly be created in the judicial system of one Federal court having the power of reviewing the decisions of another of equal rank in other respects; and that if a court other than the Supreme Court of the District of Columbia should take jurisdiction in supposed harmony with the provisions of section 4915, it would be unable to execute its own decree.

Again, the construction of the statutes now urged upon this court has received the judicial sanction of the only tribunal before whom the point was ever distinctly raised prior to this case, and such tribunal, after full argument by able counsel on both sides, delivered a careful and elaborate opinion against its own jurisdiction. (See decisions of Hon. A. Randal, judge of the U. S. circuit court, third district, in case of Prentiss *v.* Ellsworth, reported in *Mirror* of the Patent Office for 1846, p. 35; 2 Wharton Digest, 365.)

This decision of Judge Randal is the more important because it was rendered shortly after the passage of the act corresponding with the present section 4915, when the courts might more readily ascertain the meaning of the legislature.

The following list of cases comprise, I think, all decided under 4915, and analagous sections:

Prentiss *v.* Ellsworth, *Mirror* of Patent Office, 1846, p. 35, republished in 27 O. G., 623, *ex parte* Greely, 6 Fisher.
Atkinson *v.* Boardman, Laws Digest, 666.
Union Paper Collar Co. *v.* Crane, 6 O. G., 801.
Ellithorpe *v.* Robertson, 2 Fisher, 83.
Runstettler *v.* Atkinson & Marble, 23 O. G., 940.
Whipple *v.* Minor, 23 O. G., 223.
Damon *v.* Eastwick, 22 O. G., 1709.
John J. Squires, 12 O. G., 1025.
Butler *v.* Shaw, unreported.
Bunker & Briesdorf *v.* Butterworth, unreported.

Of these, Prentiss *v.* Ellsworth was the first, and seems to have established the practice so satisfactorily that not another suit of this character was brought outside of the courts of the District of Columbia for more than twenty years. However, this was published in a periodical and not in any of the regular law reports, and so after a series of years it seems to have been forgotten, since in the suits thereafter brought no mention is made of it. It was only by accidentally discovering a reference to it in an old Commissioner's report that I was enabled to trace it, and was thereby led to investigate this jurisdictional question. In none of the other cases included in the above list was the question of jurisdiction raised and decided save in Butler *v.* Shaw, and Bunker & Briesdorf *v.* Butterworth, which will be presently referred to.

In two or three cases general remarks have fallen from the court as to the nature of a bill in equity contemplated by section 4915, but these remarks do not affect the question now being considered.

In Butler *v.* Shaw, occurs the following language: "It is only in other cases of rejection (than on interference) by the Commissioner of an application for a patent, that an appeal may, perhaps must, be taken to the Supreme Court of the District of Columbia, and be decided by that court against the applicant, before he may file a bill in equity." The case before the court was a contest between two applicants for a patent and was not a suit against the Commissioner, and they, by the above quoted language, clearly recognize the necessity in the latter class of cases for the resort to be had in the first instance to the Supreme Court of the District of Columbia.

Now the case at bar was never appealed to the Supreme Court of the District of Columbia, and hence, under the decision just quoted, could not be prosecuted by a bill in equity.

In Butler *v.* Shaw, it was not necessary, and the court did not decide that if an appeal had been taken in the first instance to the Supreme Court of the District of Columbia, that a bill in equity could be afterward prosecuted in any circuit court and I do not think that upon a full argument the court would so decide, but even that is not necessary to be considered in this case.

In the case of Bunker & Briesdorf *v.* Butterworth, Commissioner of Patents, Judge Blodgett dismissed the bill brought under Section 4915, and did it on the ground of the lack of authority under the statute, for any other court than the Supreme Court of the District of Columbia to entertain a bill of that character. In the case before Judge Blodgett the opinion of Judge Wheeler in the case at bar was carefully discussed, and Judge Blodgett found himself unable to agree with such opinion.

But though, since Prentiss *v.* Ellsworth, and prior to this case, there seem to have been no declaration from the courts as to the meaning of this section, Congress has not been similarly silent, but, on the contrary, has expressed its intention in unmistakable language.

Section 780, Revised Statutes relating to the D. C. post roads and public treaties, provides: "The Supreme Court sitting in banc shall have jurisdiction of and shall hear and determine *all* appeals from the decisions of the Commissioner of Patents in accordance with the provisions of section forty-nine hundred and eleven to section *forty-nine hundred and fifteen, inclusive*, of chapter one, title LX of the Revised Statutes, 'patents, trade-marks, and copyrights.'"

Now it will be remembered that section 4915 is the one giving the remedy by bill in equity, hence by the section last quoted the suit instituted by such a bill (at least so far as it calls for a review of the decision of the Commissioner of Patents) must be heard and determined by the Supreme Court of the District of Columbia sitting in banc. This section thus by express terms withholds jurisdiction in cases of this character from all other courts than the Supreme Court of the District of Columbia.

In view of the foregoing it is respectfully submitted that the court below did not have jurisdiction of the subject-matter of the suit, and hence could not decide the cause whether or not the Commissioner of Patents accepted service of the writ.

The application forming the basis of this suit was filed by Hill & Prentice on the 36th of March, 1880, and in it is made four claims which are accurately set out in the complainant's bill forming a part of this cause. The subject-matter of these claims is fully described and shown in the patent granted to said Hill & Prentice on the 3d of September, 1878, but said subject-matter is not claimed, reserved, nor notice of the patentees right thereto announced in such patent.

The question for determination is, whether the inventions now claimed were not abandoned or dedicated to the public by the exhibition of them in the patent without any assertion of right thereto.

An inventor, if he so elects, may by express declaration abandon or dedicate his inventon to the public. But in the case at bar there is no evidence that the invention has been abandoned by the expressed intention of the inventor. Has the invention been abandoned by the acts of the inventor? In the case of Shaw *v.* Cooper, (7 Peters, 292,) the Supreme Court says:

"No matter by what means an invention may be communicated to the public before a patent is obtained, any acquiescence in the public use by the inventor will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time could give it validity. But the public stand in an entirely different relation to the inventor. The invention passes into the possession of innocent persons who have no knowledge of the fraud, and at a considerable expense, perhaps, they appropriate it to their own use. The inventor, or his agent, has full knowledge of these facts but *fails* to *assert* his right. Shall he afterward be permitted to assert it with effect? Is not this such evidence of acquiescence in the public use on his part as justly forfeits his right? If an individual witness a sale and transfer of real estate, under certain circumstances in which he has an equitable lien or interest, and does not make known this interest, he shall not afterward be permitted to assert it. On *this principle* it is that a discoverer abandons his right if before the attainment of his patent his discovery goes into public use. His right would be *secured by giving public notice that he was* the inventor of the thing used and that he *should apply for a patent.*"

And further on in the same decision the following language is employed:

"Whatever may be the intention of the inventor, if he suffers his invention to go into public use, *through any means whatsoever*, without an immediate *assertion of his right*, he is not entitled to a patent; nor will a patent obtained under such circumstances protect his right."

In this decision, rendered more than fifty years ago, in the infancy of the patent system of this country, we find a clear and accurate exposition of the principle underlying the doctrine of constructive abandonment.

In whatever manner the public gains a knowledge of the invention, the right to the use of this knowledge becomes absolute unless the inventor immediately asserts his right. The manner pointed out in the decision for asserting his right is "by giving *public notice* that he was the inventor of the thing used and that *he should apply for a patent.*" The facts before the court in Shaw *v.* Cooper were that the invention had been publicly used and thereby the public had gained a knowledge of it; but the language of the court and the principle upon which the decision rests cover a case where information of the invention was communicated to the public through the medium of a patent.

In The Suffolk Co. *v.* Hayden, (3 Wall., 315,) the point was raised that a description of an invention in a patent and *ommission to claim it therein* operated as an abandonment or dedication of it to the public, and for that reason a subsequent patent claiming the said invention was void. The court said:

"But the answer to the ground of defense is, that it appeared that Hayden, the patentee, had pending before the Commissioner of Patents an application for the same improvement at the time he described it in the specification of the 17th of March, which was doubtless the reason for not claiming it in this patent. The description in no sense affected this application thus pending before the Commissioner; and while it remained before him repelled any inference of abandonment or dedication from the omission to again claim it."

Here the principle announced in Shaw *v.* Cooper, *supra*, is again recognized and applied to the extent called for by the facts; for abandonment or dedication to the public was held not to result from a description of an invention in a patent even though it was not claimed therein, in case *another application claiming such invention was pending before the Commissioner at the time the patent was issued.* In other words, the pending application negatived the idea of abandonment of the inventor's right to the invention which was described though not claimed in the patent.

In the case of O'Reilly *v.* Morse, (15 How., 62,) the court says:

"It is said, however, that this alleged improvement is not new and is embraced in his former specification; and that if some portion of it is new it is not so described as to distinguish the new from the old. * * * All that we think is useful or necessary to say is, that after a careful examination of the patents, we think the objection on this ground is not tenable."

In this case, though the point now in controversy was raised, yet the decision seems to have turned on the correctness of the counsel's apprehension of the facts upon which the point was based, and as the court found an error in the statement of the facts, it was unnecessary to examine the legal proposition involved.

In the case of James *v.* Campbell, 21 O. G., 337, the following language is used:

"The same combination of post-marker and blotter was also exhibited in Norton's patent of August 9, 1859. As he did not *then reserve* the process of stamping letters with such an instrument, nor the combination of a post-marker and a blotter, and did not make any simultaneous application therefor, he could not afterward obtain a patent for such process and combination, but would be restricted to such particular combination or process as might be exhibited in a new device or apparatus."

The rule suggested by these words is that to retain his right to an invention exhibited, but not claimed in a patent, the inventor must, at the time of the issuance of the patent, signify his intention to reserve it for a future application, or he must evidence such intention by filing an application claiming such invention prior to the issuance of the patent in which it is shown.

Further on in the case of James *v.* Campbell, the court says:

"It is hardly necessary to remark that the patentee could not include in a subsequent patent any invention embraced or described in a prior one granted to himself any more than he could an invention embraced or described in a prior patent granted to a third person. Indeed, not so well; because he might get a patent for an invention before patented to a third person in this country if he could show that he was the first and original inventor, and if he should have an interference declared. Now, a mere inspection of the patents referred to above will show that after December, 1862, Norton could not lawfully claim to have a patent for the general process of stamping letters with a post-mark and canceling-stamp at the same time, nor for the general combination of a post-stamper and blotter in one instrument, nor for the combination of a post-stamper and blotter connected by a cross-bar, for all these things, in one or other specific form, were exhibited in these prior patents."

Thus it will be seen that the court entertained positive views as to the illegality of claims covering subject-matter described in a prior patent. Of course this latter paragraph must be construed in connection with the one first quoted from the James *v.* Campbell decision, in which it is suggested that an assertion of right, either by a reservation clause or by a simultaneous application, would prevent abandonment from resulting from a failure to make a technical claim in a prior patent. But it has been contended that the court in the James *v.* Campbell case intended merely to hold that an inventor could not obtain a second patent for the same thing covered by his first patent. This interpretation, however, is not consistent with the language employed in the decision.

In stating the reasons why Norton could not obtain a patent for certain inventions, the court say that such inventions were "exhibited" in his own prior patent, and yet he neither then reserved them nor filed a simultaneous application therefor. Now, how can it be reasonably argued that either a reservation of or a simultaneous application for particular inventions *claimed in a patent* could justify a second patent for said inventions? And the word used in the other quotations made from this decision equally forbid any such construction contended for as aforesaid. James *v.* Campbell not only is consistent with but plainly confirms Shaw *v.* Cooper in reference to the doctrine of constructive abandonment.

The one case decided by the Supreme Court of the United States which is inconsistent with the principle I am now advocating is Battin *v.* Taggart, (17 Howard, 74;) and the present standing of that case may be ascertained by the following language of Judge Lowell:

"None of these cases, unless it be Battin *v.* Taggart, (17 Howard, 74,) which is perhaps inconsistent with Leggett *v.* Avery (101 U. S., 256,) have been overruled." (See Smith *v.* Merriam, 6, Fed. Rep., 810.) At the time Judge Lowell delivered his opinion the cases of Miller *v.* The Bridgeport Brass Co., (14 Otto, 350,) James *v.* Campbell, *supra*, and others of the same character had not been decided, and hence his language was much milder than if he could have anticipated the strict views advanced by the Supreme Court in these latter cases.

In Miller *v.* The Bridgeport Brass Co., the court say:

"It must be remembered that the claim of a specific device or combination and an omission to claim other devices or combinations apparent on the face of the patent are in law a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or if his he dedicates it to the public."

And then the court go on to say that this dedication can only be avoided by proving that the omission of the claims was by inadvertence, accident, or mistake, and the correction must be made by reissue, which must be filed with due diligence and speed.

And so it will be seen that this decision is in accord with the others heretofore referred to, for it is held therein that an omission to claim a device or combination is in legal effect an abandonment or dedication of it to the public; the only remedy being a speedy application for a reissue, and proof that the omission arose through inadvertence, accident, or mistake.

The decisions of Marvin *v.* Lillie, 27 O. G., 299, Swift *v.* Jenks, 27 O. G., 621, and McKay *v.* Jackman, 12 Fed. Rep., 615, are to the same effect. Of these the last-mentioned was decided by Judge Wheeler, and in it he took precisely the opposite view to that advanced by him in this case; and Swift *v.* Jenks was decided after the publication of Judge Wheeler's opinion in this case, and by a judge in the same circuit.

When tested by the rule announced in the decisions of the Supreme Court and the other decisions herein discussed, it is manifest that the application upon which this cause is founded should be rejected, inasmuch as its subject-matter has been abandoned or dedicated to the public.

Frank T. Brown
Of Counsel

114-128

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Supreme Court of the United States.

OCTOBER TERM, 1884.

No. 1044.

BUTTERWORTH, COMMISSIONER OF PATENTS,
APPELLANT,

vs.

SAMUEL HILL, BENJ. B. PRENTICE, AND THE VERMONT FARM MACHINE COMPANY.

APPELLEE'S BRIEF.

Supreme Court of the United States.

OCTOBER TERM, 1884.

No. 1044.

BUTTERWORTH, COMMISSIONER OF PATENTS,
APPELLANT,

vs.

SAMUEL HILL, BENJ. B. PRENTICE, AND THE VERMONT FARM MACHINE COMPANY.

APPELLEE'S BRIEF.

SHORT EXPLANATION.

Samuel Hill and Benjamin B. Prentice of Vermont, assignors to the Vermont Farm Machine Company also of Vermont, filed in the Patent Office March 30, 18~~78,~~80 an application for a patent on improvements in Milk Setting Apparatus. On the 26th day of April, 1883, the Commissioner of Patents rejected the first, second, third and fourth claims of that application on the ground that the subject-matter thereof, though not claimed, was shown in a prior patent to applicants, No. 207,738, dated September 3, 1878. Thereupon said applicants, proceeding under Section 4915 of the Revised Statutes, brought their petition to the United States Circuit Court for the District of Vermont, asking that court to decree that said applicants "are entitled according to law to receive a patent for said invention of Hill and Prentice as specified in their said four clauses of claim." There being no adverse party a copy of the bill was served upon the Commissioner of Patents, the Hon. E. M. Marble (he also accepted service of a subpœna such as is commonly used in equity cases); he did not enter an appearance in court. Thereupon, for formality's sake, a decree was entered for said applicants *pro confesso ;* afterwards the petition was heard at full length by his Honor, Judge Wheeler, and the circuit court decreed that said applicants are entitled to have letters patent as prayed for in said petition. Thereafter another Commissioner of Patents, the Hon. Benjamin Butterworth, moved that said decree of said circuit court be set aside and a re-hearing granted, which motion was heard at length by Judge Wheeler and denied. Thereupon the last mentioned Commissioner of Patents, the Hon. Benjamin Butterworth, took appeal to this court and upon his *ex parte* motion the case has been advanced upon the docket. This brief explanation of the case at bar will be more fully elaborated in a subsequent part of this brief but this present statement suffices for the purposes first in hand.

I.

COMMISSIONER'S OBJECTIONS LIMITED.

No plea, answer, demurrer, or other pleading, was ever filed in this cause by respondent in the court below, and no leave was ever asked to file any, and the only objection to the decree of the court below which is now open to the Commissioner of Patents to urge is, an objection to the regularity of the form of the decree which, we apprehend, is entirely unobjectionable. Whether such a cause is appealable to this court is a question which appellant now raises.

II.

JURISDICTION OF COURT BELOW.

If this court should decide that appellant can make objections to the decree of the circuit court not based on any pleading filed by appellant, the first question which naturally comes up for consideration is that of jurisdiction on the part of the court below.

Section 4915 of the Revised Statutes is:

"SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

The Commissioner's position—as stated to the circuit court—is broadly to the effect that none of the regular circuit courts of the United States have any jurisdiction under Sec. 4915, in any case whatever. In his brief used in the court below, the Commissioner stated his position by saying: "There can not be a reasonable doubt of the sole jurisdiction of the Supreme Court of the District of Columbia in suits of the character of the one at bar." This broad position of the Commissioner of Patents is disposed of very briefly—for it is utterly untenable—by pointing to the following cases:

Ellithorpe v. *Robertson*, 2 Fisher's Pat. Cases, 83.
Whipple v. *Miner*, 15 Fed. Rep. 117.
John J. Squire's Case, 3 Banning & Arden, 133.
Butler v. *Shaw*, 21 Fed. Rep. 321.

The Commissioner's strongest position, allowing us to state it, is that while the regular circuit courts have jurisdiction under Sec. 4915 where there is an "opposing party," a regular circuit court can not take jurisdiction where there is no opposing party until after an *appeal* has been taken from the Commissioner of Patents to the Supreme

Court of the District of Columbia. This is unquestionably the real question in the case—so far as the question of jurisdiction is concerned.

Let us with this understanding of what the Commissioner's position ought to be, proceed to consider his objections.

THE COMMISSIONER'S FIRST POINT in support of his position is that to permit one of the regular circuit courts of the United States to take jurisdiction under Sec. 4915, is to create the anomaly of permitting one court to review the decision of another court of equal rank.

The Commissioner has fallen into a mistake on this point. If a petition is brought to the Supreme Court of the District of Columbia, under Sec. 4915, the decision of that court is not reviewable by any circuit court of the United States: it is only reviewable by the Supreme Court of the United States. In any case which comes to the Supreme Court of the District of Columbia from the Patent Office, it is only when an *ex parte* application for a patent is refused "by the Supreme Court of the District of Columbia upon *appeal* from the Commissioner," that the applicant can proceed under Sec. 4915, in any court. The two cases are entirely different cases. "Upon *appeal* from the Commissioner" the Supreme Court of the District of Columbia can consider only that evidence which was before the Commissioner. In proceeding under Sec. 4915 the proceeding is *de novo*: any court proceeding under this section proceeds as a court of original and not appellate jurisdiction. (*Butler* v. *Shaw,* supra, Walker on Patents, par. 134)

The Commissioner concedes that after the Supreme Court of the District of Columbia has once heard and decided an *ex parte* application for a patent "upon *appeal* from the Commissioner," the applicant may still proceed in that same court, and *de nova,* under Sec. 4915. Yet the Commissioner would deny to the regular circuit courts of the United States the same right, thus making the Supreme Court of the District of Columbia not only equal to, but greater than the regular circuit courts of the United States, which is an absurdity.

THE COMMISSIONER'S SECOND POINT in support of his position is based upon the following:

"Sec. 780. The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents in accordance with the provisions of Sec. 4911 to Sec. 4915 inclusive of Chapter I, Title LX of the Revised Statutes, 'Patents, Trademarks and Copyrights.'"

The Commissioner has fallen into a mistake here in that he has overlooked the fact that said Sec. 780 refers exclusively to *appeals* from the decisions of the Commissioner of Patents. A proceeding under Sec. 4915 is not an appeal from the Commissioner of Patents. A court proceeding under Sec. 4915 acts as a court of original and not appellate jurisdiction, as has been already pointed out.

THE COMMISSIONER'S THIRD POINT in support of his position is that it would be extremely inconvenient for the Commissioner to be called upon "to produce papers, models, &c.," in the various circuit courts of the United States.

The Commissioner has fallen into a mistake on this point in supposing or assuming that under Section 4915 the Commissioner can be made to produce the models and papers of the Patent Office in the different circuit courts of the United States. No such thing can be done. It is incumbent upon the petitioner proceeding under Section 4915, in any court, to support the allegations of his petition by producing in court a certified copy of the record in the Patent Office appurtenant to the application in question. The only way in which it is proper for an applicant proceeding under Section 4915 to prove the character or contents of any model or paper in the Patent Office is to procure from the Patent Office, by paying for it as the law directs, a certified duplicate or copy of such model or paper and file the same in court. There is nothing whatever in this objection on the part of the Commissioner. No model or paper in the Patent Office can ever be disturbed by an applicant proceeding in any court under Section 4915.

THE COMMISSIONER'S FOURTH POINT in support of his position is that it would be extremely inconvenient for the Commissioner to attend in the various circuit courts and defend against applicants proceeding under Section 4915.

Again the Commissioner has fallen into a mistake in assuming or supposing that there is any necessity that the Commissioner should appear and defend in any such suit. Doubtless he would be permitted to appear and defend in a case where he made it clear that the public and the government would be served thereby. But why should the Commissioner appear and defend ordinarily in such suits? Is it supposable that a judge of a United States Circuit Court is any less a faithful servant of the government and of the public than is the Commissioner of Patents? Is it supposable that a judge will be less solicitous to defend the rights of the government and of the public than a Commissioner of Patents? Is it supposable that the judges of the United States courts with their life tenure and with their constant practice in deciding patent causes wherein the contests are of a much higher order than the contests which take place in the Patent Office, are less competent to defend the rights of the public and of the government than are the Commissioners of Patents with their short tenure and thrown in and out of the office as they are by the revolutions of the policical roulette? To state these questions is to answer them. The clear and convincing answer is that the Commissioner proceeds *ex parte* in deciding an application and the judge is every way as competent to proceed *ex parte* in the same matter as is the Commissioner. It is a matter of common knowledge that practically the United States Circuit Court is very much the more competent tribunal than is the Patent Office. The language of the statute as well as the exercise of common sense points to the conclusion that the statute intends that the judge of the court shall proceed *ex parte*, and that the service of a copy of the *bill* upon the Commissioner is not meant to be legal service of *process* but is meant to be simply a notification to the Commissioner of the pendency of the suit, so that if some unusual or extraordinary question arises he may in such exceptional case and for the public interest, appear and defend if he chooses.

THE COMMISSIONER'S FIFTH POINT is that one of the regular circuit courts can not compel the Commissioner of Patents to execute its decree by a mandamus. This particular and unworthy objection was properly characterized by his Honor, Judge Wheeler, in words as follows:

"It is further objected against the jurisdiction here, that the court here could not compel obedience of the Commissioner at the Patent Office to its decree. It is to be presumed, however, that a high officer of a department of the government will do his duty without compulsion or even command from any quarter, especially in a matter where he has no interest nor the government any except that the duty be done. This provision of the statute is framed according to this view."

To raise this objection is to trample under foot the respectful deference which Congress paid to the Commissioner of Patents in framing the law as it did. This objection deserves and will have at our hands no further notice.

THE COMMISSIONER'S SIXTH POINT is that an appeal under Sec. 4915 must necessarily be brought in a district of which the Commissioner is an inhabitant, because otherwise service of process can not be made on the Commissioner.

Appellee's First Answer to this first point is that such a view of Sec. 4915 is a narrow and mistaken view. That section of the statute contemplates substantially an *ex parte* proceeding before a judge of the United States Circuit Court, leaving the judge to inquire into the merits and patentability of the thing sought to be patented precisely as the Commissioner of Patents inquires into the merits and patentability of the thing sought to be patented: in either case the finding is to be based upon such evidence as is produced before the tribunal where the question is pending.

The proceeding contemplated by Sec. 4915 is not a suit *against* the Commissioner of Patents. The service of a copy of the *bill* upon the Commissioner as directed in Sec. 4915, is not the bringing of a suit against the Commissioner, nor the notice of the beginning of an equity suit which the statutes regulating that matter call for. When an equity suit is begun against a party, a *subpœna* issues from the court and is served upon the defendant. The service of a copy of the *bill* upon the Commissioner, called for by Sec. 4915, is not that thing at all: it simply informs the Commissioner of precisely the question which the applicant has brought to the court, and doubtless it is proper for the Commissioner to appear and defend in behalf of the government, if some unusual and extraordinary question arises which in his judgment warrants such a step. If the statute had meant to say that the legal service of process must be made upon the Commissioner it would have used the ordinary language indicating such a thing, and in going so far as to mention the precise paper to be served, it would have mentioned the proper paper, the *subpœna*, and not a copy of the *bill.*

Appellee's Second Answer to this point of the Commissioner is, that whatever force it might have when properly raised it can not be raised in this case for the Commissioner set it forever at rest by the following acceptance of service on the *subpœna :*

"WASHINGTON, D. C., Oct. 18, 1883.

I hereby accept service of the within *subpœna* to have the same effect as if duly served on me by a proper officer, and I do hereby acknowledge the receipt of a copy thereof.

E. M. MARBLE,
Commissioner of Patents."

There ought not to be any doubt as to what this means. The Commissioner in taking this appeal has acknowledged that this is a proper acceptance of service by using the following words in his appeal below, to wit. : "Which said *subpœna* was duly returned into court with the service thereof accepted by the said E. M. Marble then Commissioner of Patents."

The statement contained in Mr. Marble's endorsement is that he does "accept service"; that such acceptance is to have the same effect as if "*duly* (*i. e.* legally) served on me by a proper (*i. e.* legally acting) officer."

Judge Wheeler on this point:

"In *ex parte* Schollenberger (96 U. S. 369) Mr. Chief Justice Waite, in delivering the opinion of the court, says:

'The Act of Congress prescribing the place where a person may be sued is not one affecting the general jurisdiction of the courts. It is, rather, in the nature of a personal exemption in favor of a defendant, and one which he may waive. If the citizenship of the parties is sufficient, a defendant may consent to be sued anywhere he pleases, and certainly jurisdiction will not be ousted because he has consented.'

Here no question was made before. Now where one on this subject is made, it is not whether the Commissioner can be compelled to answer, but whether he can consent to be sued away from the seat of government and his residence. *Prentice* v. *Ellsworth,* * * , raised the question as to the compulsion and not as to the consent and it was held, upon apparently sound reasoning by Randall, J., that the Commissioner could not be compelled by process issuing out of the circuit court for the Eastern District of Pennsylvania to answer there. The question of jurisdiction founded on consent did not arise."

Prentice v. *Ellsworth* (27 O. G. 623) on this point:

"The prohibition of the service of process out of the jurisdiction is, however, a personal privilege which may be waived."

We have now met every point raised by the Commissioner. Let us next turn our attention to a few positive reasons why a regular circuit court of the United States may take jurisdiction under Sec. 4915 of an *ex parte* application rejected by the Commissioner and not *appealed* to the Supreme Court of the District of Columbia.

First. The *terms* of the statute clearly permit the applicant to go from the Commissioner to a regular circuit court, for the statute says: "Whenever a patent on application is refused * by the Commissioner of Patents * * the applicant may have remedy by bill in equity, &c."

Second. The statute is clearly remedial in its nature, and on settled principles must have a liberal construction.

Third. The text-writers, so far as they touch this question, agree that the applicant may go from the Commissioner's rejection to a circuit court under Sec. 4915.

"The litigation explained in this section is therefore original and not appellate litigation. It may be resorted to as concurrent remedy with *appeal* to the Supreme Court of the District of Columbia."

Walker on Patents, par. 134.

Fourth. To hold that an applicant may not go from the rejection of the Commissioner to a regular circuit court under Sec. 4915 without first taking an appeal to the Supreme Court of the District of Columbia, tends to compel useless litigation. By the time an application has reached the Commissioner of Patents, and been decided by him, the applicant will generally find that it is incumbent on him to introduce new facts in evidence, if he would further prosecute his application. This he would naturally do by proceeding under Sec. 4915, and to hold that he can not, at this point, proceed under that section, is to compel him to take upon himself the burden and expense of a useless litigation in the Supreme Court of the District of Columbia simply to reach the point where he may begin proceeding under Sec. 4915.

Making an appeal from the Commissioner to the Supreme Court of the District of Columbia and a proceeding under Sec. 4915 concurrent remedies, is a wise and judicious thing, for by the time that an applicant has reached the Commissioner and been rejected by him, he will have learned either that the Commissioner of Patents is so clearly mistaken that an appeal to the Supreme Court of the District of Columbia will answer his purposes, or that he needs to strengthen his case by additional evidence, to do which he must proceed under Sec. 4915.

Fifth. The *de novo* proceeding of Sec. 4915 was created before the *appeal* to the Commissioner was created.

The *de novo* proceeding of Sec. 4915 first appeared in the Act of 1836. (Sec 16.)

The *appeal* first appeared in the Act of 1839 (Sec 11). If this order had been reversed it might plausibly be said that the *appeal* must be taken before proceeding under Sec. 4915. Tke facts forbid any such thing to be said.

III.

THE MERITS OF THE CASE.

Samuel Hill and Benjamin B. Prentice had issued to them letters patent for improvement in Milk Coolers, No. 207,738, dated Sept. 3, 1878, a copy of the specification and drawing of which is annexed.

S. HILL & B. B. PRENTICE.

Milk-Cooler.

No. 207,738. Patented Sept. 3, 1878.

Fig. 1.

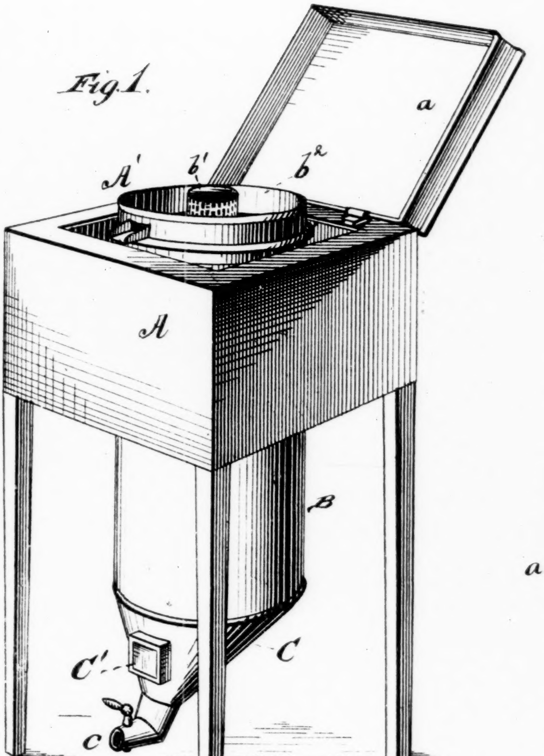
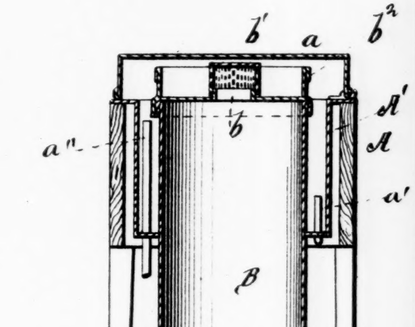


Fig. 2.



WITNESSES

Robt Everett

Jas. J. Sheehy.

INVENTORS.

Samuel Hill.

Benjamin B. Prentice

Gilmore, Smith & Co.

ATTORNEYS

UNITED STATES PATENT OFFICE.

SAMUEL HILL AND BENJAMIN B. PRENTICE, OF GREENSBOROUGH, VT.

IMPROVEMENT IN MILK-COOLERS.

Specification forming part of Letters Patent No. **207,738**, dated September 3, 1878; application filed July 13, 1878.

To all whom it may concern:

Be it known that we, SAMUEL HILL and BENJAMIN B. PRENTICE, of Greensborough, in the county of Orleans and State of Vermont, have invented a new and valuable Improvement in Milk Cans and Coolers; and we do hereby declare that the following is a full, clear, and exact description of the construction and operation of the same, reference being had to the annexed drawings, making a part of this specification, and to the letters and figures of reference marked thereon.

Figure 1 of the drawings is a perspective view of our milk can and cooler, and Fig. 2 is a vertical central sectional view of the same.

The nature of our invention relates to a can for cooling milk and perfectly and quickly forming cream.

The invention consists in a cylindrical can having a conical bottom, the upper part of said cylinder being surrounded with a square ice-box or water-tank, provided with an aperture, which is covered with a perforated cap to afford ventilation. The water-tank is provided with an inlet and an outlet tube, the open top of the outlet being elevated to near the top of the tank. A hinged cover operates over the whole, and suitable legs are provided.

Near the bottom of the conical portion is a window, which allows inspection of the contents of the can, and a stop-cock at the lower extremity serves to draw off the same, when desired.

The conical bottom serves to deflect and precipitate dirt to the small end, from whence it is readily removed through the stop-cock.

The can being suspended in the tank allows the water or ice to be applied to the upper part of the can, while the lower part being exposed to the warmer atmosphere of the room causes the cream to rise rapidly and completely, and after it has risen it is kept cool by the surrounding ice or water.

After the cream has sufficiently risen the milk may be drawn off through the stop-cock until the cream is discernible through the window, and then the cream may be drawn off in another vessel.

Referring to the drawing, A represents a square water or ice tank, such ice or water chamber being shown at A′. This tank is supported on proper legs or supports, and the ice-chamber A′ is provided with water-inlet *a*′ and outlet *a*″. A hinged cover, *a*, covers the chamber A′.

B represents a cylindrical can suspended within the tank, a portion of it extending below. This cylinder has an inlet-orifice in the top at *b*, covered by perforated cap b^1, through which the cream-chamber is ventilated. A collar, b^2, extends above the top of the cylinder, and it is provided with a sluice, which allows any spilled milk to run out, and the collar prevents water from running in.

At the lower end of the cylinder B is the conical portion C, having a stop-cock, *c*, at the lower or smaller end for drawing off the contents of the can, and a window, C′, framed therein for inspecting such contents.

The operation of our invention, from the foregoing description, is obvious, and the advantages apparent.

What we claim as new, and desire to secure by Letters Patent, is—

The cylindrical can B, having ventilated orifice *b* b^1 and cone C, in combination with and partially surrounded by the ice or water tank A A′, as and for the purpose set forth.

In testimony that we claim the above we have hereunto subscribed our names in the presence of two witnesses.

SAMUEL HILL.
BENJAMIN B. PRENTICE.

Witnesses:
JOHN H. GEORGE,
EDMUND H. GEORGE.

'in the milk vessel near the outlet for the purpose of permitting the 'user of the apparatus to distinguish when to close the cock, in the 'act of separating the milk from the cream by drawing the milk out 'from beneath the cream; the manner of using the apparatus for 'this purpose being, in general terms, to put the fresh milk into the 'milk vessel, surround the milk vessel with the cooling agent and 'when the cream has risen upon the milk open the cock, permit the 'milk to run out until the cream is close down to the outlet, and 'then close the cock; afterwards the cream can be drawn off through 'the cock into another vessel at pleasure.

'The milk vessel has a cover *C*, provided with a pendant rim *c* 'and an uprising rim *c'*, it is intended that the pendant rim *c* shall 'dip down into the cold water within the cooling chamber when 'water is used as a cooling agent, and the uprising rim is intended 'to form a cup or shallow vessel in which ice, water, water and ice, 'or other suitable cooling agent may be placed so that the milk 'vessel may be cooled from the top as well as from the sides; 'the letter *d* denotes a spout which will carry off any water from 'the top of the cover when ice is used upon the cover and it is 'desired that the drip shall thus be carried away; the letter *d'* 'denotes a ventilator rising from the cover *C* and perforated with 'small holes for the escape of any gases that may generate in the 'milk vessel on placing the fresh milk therein.

'The letter *D* denotes a box or casing surrounding the chamber *A*, 'made of wood or of other suitable material which will not readily 'permit the passage of heat; it rests upon suitable supports (of 'which more hereinafter), so as to suitably raise the outlet and cock 'to give space thereunder for the insertion of vessels to receive the 'milk and cream; and it is provided upon the top with a hinged lid 'or cover *E* which may be opened to permit access to the cooling 'chamber for introducing the milk to the milk vessel, for introducing 'the cooling agent to the cooling chamber and for examination, 'regulation and cleaning of the same; and for other proper 'purposes.

'The structure shown in Figure 1 of the drawings, not only has 'the upper chamber or compartment *A* but also has a lower cham-'ber or compartment *B*, cased in with wood, or other suitable non-'conductor of heat, upon the sides and bottom, which casings form 'suitable supports for the upper compartment and its appurtenances;

'the lower chamber or compartment is furnished with a door *a''*
'through which access may be had to the chamber for the purposes
'indicated in this specification and for any other proper purposes.
'The upper chamber is divided from the lower chamber not only
'by the bottom of the tank, but also by the wooden partition *a.*
'The lower chamber or compartment serves to protect that part
'of milk vessel which is in contact with this chamber from free
'contact with the outer air, preventing the temperature from unduly
'varying; and it also serves as a suitable place wherein to store
'butter, milk or dairy appliances, this being practically a refrigerating
'ting chamber. The outer casing of the upper and lower compartments
'ments forms what we call a cabinet.

'We claim as our improvement:

'1. The open top cooler tank combined with the milk vessel
'having a non central outlet and its bottom descending throughout
'its whole extent to side outlet, substantially as described and for
'the purposes set forth.

'2. The combination of a box, an open top cooler tank within
'the box, a milk vessel within and extending below the cooler tank,
'having at its lower end an outlet, a cock and a transparent pane,
'substantially as described and for the purposes set forth.

'3. The combination of a box, an open top cooler tank within
'the box, and a milk vessel extending through and below said tank,
'and having at its lower end a contracted outlet, a cock, and a transparent
'parent pane, substantially as described and for the purposes set
'forth.

'4. The combination of the cooler tank, the milk vessel extending
'ing below the tank, an outlet at the lower end of said milk vessel,
'a cock in said outlet, and the box and its cover enclosing the sides
'and top of the cooler tank, the whole being mounted on proper
'supports, substantially as described and for the purposes set forth.

'5. The combination with a cabinet provided at its top with a
'cover or lid and having a door in its side, of a cooler tank located in
'the upper portion of the cabinet, and a milk vessel, the upper portion
'tion of which is located within the cooler tank and its discharge
'conduit arranged to extend below the cooler tank, substantially as
'described and for the purposes set forth.

'6. In a milk cooling apparatus, the combination, with a cabinet 'or box having its top and sides provided with covers or doors, 'of a milk vessel provided with a discharge regulating valve or stop 'cock, at its lower end, and a cooler tank having an open top and 'surrounding the upper portion of the milk vessel, substantially as 'described and for the purposes set forth.

'7. A milk cooling apparatus consisting essentially of a milk 'vessel provided with a discharge opening at its lower end, a cooler 'tank having an open top and surrounding the upper portion of the 'milk vessel, and a cabinet having a cover which extends over the 'milk vessel and cooler tank, and with a side door for preventing 'admission of the outer air to the lower portion of the milk vessel 'when desired, substantially as described and for the purposes set 'forth.

'8. A milk cooling apparatus consisting of the cabinet provided 'with an upper and lower compartment, a cooler tank having an 'open top and located in the upper compartment of the cabinet, a 'milk vessel, the upper portion of which is located in the cooler 'tank and its lower end constructed to project down into the lower 'compartment of the cabinet, and a valve or stop-cock connected 'with the lower end of the milk vessel, substantially as described 'and for the purposes set forth.

'9. A milk cooling apparatus consisting of the cabinet provided 'with an upper and lower compartment, a cooler tank having an 'open top and located in the upper compartment of the cabinet, a 'milk vessel, the upper portion of which is located in the cooler 'tank and its lower end constructed to project into the lower part 'of the cabinet, a valve or stop-cock connected with the lower end 'of the milk vessel, and a transparent pane in the milk vessel and 'in juxtaposition with the stop-cock, all substantially as described 'and for the purposes set forth.

'In testimony whereof we affix our signatures in presence of two 'witnesses.

'SAMUEL HILL,
'BENJAMIN B. PRENTICE.

'Witnesses:
'WM. B. SAWYER,
'F. C. BATCHELDER."

On the 23d day of January, 1883, the Examiner in charge of the application rejected claims 1, 2, 3, and 4, on the ground that they "are met by the prior patent to applicants, No. 207,738; and according to Rule 91[1] of office practice these subjects-matter cannot be claimed in a separate application."

Applicants took appeal from this ruling of the Examiner in charge to the Commissioner in person who, on the 26th day of April, 1883, rendered the following decision:

"Applicants appeal from the decision of the examiner in rejecting their 1st, 2nd, 3rd and 4th claims on a prior patent granted to 'themselves under rule 91, because the subject-matter now claimed 'is described and might have been claimed in said patent.

'Applicants really ask that rule 91 of the Rules of Practice may 'be stricken out or so changed as to accommodate it to their and 'similar cases.

'This cannot be done. But in this case it should not be done 'even if it could be. Applicants described the invention, and claimed so much of it in their former patent as they then desired. By 'lapse of time they are unable now to reissue their patent. They 'now desire to include in a patent that which they might have claimed in their former patent:

'This they cannot do; not only under the rules of this office, 'but under the decisions of the courts. In the case of *Campbell* v. '*James*, (21 O. G. 344,) the court say:

'' It is hardly necessary to remark that the patentee could not include in a subsequent patent any invention embraced or described 'in a prior one granted to himself, any more than he could an invention embraced or described in a prior patent granted to a third 'person. Indeed, not so well; because he might get a patent for 'an invention before patented to a third person in this country if he 'could show that he was the first and original inventor, and if he 'could have an interference declared.'

'I find no error in the decision of the examiner, and therefore 'affirm the same.

'E. M. MARBLE,
'*Commissioner.*"

---

[1] Rule 91 of office practice is as follows: "91. Matter which is shown and described, and might have been lawfully claimed, in an unexpired patent, but was not claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident, or mistake, and without fraud or deceptive intent, cannot be subsequently claimed by the patentee in a separate patent, but only in a reissue of the original patent."

The patentability of the matter covered by these four claims is conceded by the Patent Office. The Patent Office concedes and the facts in evidence show that no statutory bar of two years' public use or abandonment exists. The one bald issue before the Patent Office and before this court is whether a patentee may not claim in an original application matters shown and described but not claimed in a prior patent to the same applicants when all the rights and all the patents and all the inventions belong to the same party.[1]

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[1] It has been intimated to appellee that at the hearing in this case it will be contended on behalf of the Commissioner that the claims in dispute do not, in view of the prior art, cover a patentable invention. No such issue was ever raised in the Patent Office. The Commissioner expressly decided the improvement in dispute to be patentable, and sent them into an interference which has cost these appellees many thousands of dollars. These appellees will not discuss that question here: they would not have brought that question here.

The Patent Office, in order to make its position good, ought to find warrant for it either in the statute, the precedents, or on principle. We will examine each separately.

THE STATUTE.

> "SEC. 4886. Any person who has invented or discovered any new and useful art, machine, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor."

That is the main statute applicable to the case and neither it or any other section of the statute in any way indicates or suggests that an inventor abandons to the public what he describes but does not claim, in such manner that he can not subsequently patent the same. Evidently there is no warrant in the statute for the position taken by the Patent Office.

The Precedents.

In *O'Reilly* v. *Morse*, 15 Howard 62, the Supreme Court decided that even where the device of an inventor's second patent comes within the *claim* of his first, the second patent is not thereby invalidated, using language as follows:

> "It is certainly no objection to this patent that the improvement 'is embraced by the 8th claim in the former one. We have already 'said this claim is void, and that the former patent covers nothing 'but the seven inventions specifically mentioned."
>
> "Nor can its validity be impeached on the ground that it is an 'improvement upon a former invention, for which the patentee had 'himself already obtained a patent. It is true that under the Act 'of 1836, Sec. 13, it was in the power of Prof. Morse, if he desired 'it, to annex this improvement to his former specification so as to 'make it from that time a part of the original patent."
>
> "But there is nothing in the Act that forbids him to take out a 'new patent for the improvement if he prefers it. Any other

'inventor might do so: and there can be no reason in justice or 'policy for refusing a like privilege to the original inventor. And 'when there is no positive law to the contrary, he must stand on the 'same footing with any other inventor of an improvement upon a 'previous discovery. Nor is he bound in his new patent to refer 'specifically to his former one. All that the law requires of him is 'that he shall not claim as new what is covered by a former inven-'tion whether made by himself or any other person."

The point upon which this decision was made was specially raised by him who appealed to the Supreme Court, as follows:

"2. In construing a patent and deciding what are the inventions 'patented thereby, the summing up is conclusive. Nothing is 'patented but what is expressly claimed in the summing up as the 'invention.

"3. What is described in a patent and not claimed, whether 'invented by the patentee or not, is dedicated to the public and can 'not be afterwards claimed as a part of his patent in a reissue or 'otherwise."

No question of reissue was involved here. The court was discussing two original patents. It was comparing Morse's original 1846 patent with his original patent of 1840, (both had been reissued, but this discussion concerned the two original patents.)

If a man may take by his second patent matter coming within the *claim* of his former patent, much more may he take by his second patent matter simply *described* in his former patent.

I *Batten* v. *Taggart*, 77 Howard, 74, the following state of facts was before the Supreme Court. October 6th, 1843, Joseph Batten obtained a patent on a coal breaker. February 12, 1844, he took another patent on a coal breaker wherein he referred to his said patent of 1843, as follows:

"Which rollers as combined and arranged by me are described 'as follows in the specification attached to Letters Patent for a 'machine for effecting simultaneously the breaking and screening 'of coal, granted to me under date of the 6th of October, 1843: 'the breaking part of my machine consists of two rollers of cast 'iron, the peripheries of which are provided with teeth so placed as 'that in the revolution of the rollers the teeth of each of them shall 'stand opposite to the spaces formed by two contiguous teeth on 'the opposite rollers. These rollers are geared together in order to 'preserve the same relative position."

"The manner of arranging and combining the toothed rollers are 'not made the subject of the claim, the said patent having been obtained for the combination of a roller breaking machine with a 'screen for separating the coal into the different sizes required."

"But as the breaking rollers so formed and arranged and combined, are applicable to the ordinary cylinder breaking machine, 'when not used in combination with a breaking machine, and as I 'have found by continued experiment that such rollers constitute a 'real improvement in any breaking machine, I have determined to 'secure to myself the benefit of such improvement in a distinct and 'separate patent therefor."

Both patents were surrendered and a reissue taken in 1849.

The court below charged:

"1. That a description by the applicant for a patent on a machine or a part of a machine in his specification, uneffected by 'notice that he has rights in it as inventor, or that he desires to 'secure title to it as a patentee, is a dedication of it to the public."

"2. That such a dedication can not be revoked after the machine 'has passed into public use, either by surrender and reissue or 'otherwise."

This charge was made the subject of the appeal. The Supreme Court, after quoting this charge, says:

"The above instructions we think were erroneous."

And then proceeds to show that abandonment does not follow from describing without claiming.

Batten's original patent of 1844 and his reissue of 1849, were both before the court and, so far as can now be judged, the decisions of the upper and lower courts bore alike upon both these patents. In any event, it is clear that the decision is squarely to the point that *describing* but *not claiming* an invention in an original patent does not, of itself, work abandonment thereof.

In *Suffolk Company* v. *Hayden*, 3 Wallace, 315, the facts were that Isaac Hayden, in November, 1855, applied for a patent on a cotton cleaner, which was granted March 17, 1857. In June, 1857, Hayden filed another application for a patent on a cotton cleaner, which was granted December 1, 1857. The patent of March 17, 1857, showed but did not claim what was afterward claimed in the patent of December 1, 1857. The suit was brought on the patent of December 1, 1857. The first point of the plaintiff in error was:

> "That the description in the patent of March of the improvement
> 'patented the December following and on which the present suit is
> 'brought, operated as an abandonment or dedication to the public,
> 'and that for this reason the subsequent patent of December 1 was
> 'void."

The court held that it was not void for the reason claimed.

It is true that at the time of making the application for the patent of March, 1857, Hayden had on file a still earlier application describing the same subject-matter but claiming a different subject-matter.

This case suffices to show that describing features, without claiming them in a patent, does not of itself work abandonment thereof so that such matters cannot be subsequently claimed in an original patent.

In *Singer* v. *Braunsdorf*, 7 Blatchford, 521, (Blatch. 1870,) Singer's 1856 patent was sustained against his 1851 patent on just such a state of facts as obtained in the case last cited.

In *McMillin* v. *Rees*, 17 Official Gazette, 1222, (McKennan, 1880,) McMillin had one patent granted in 1866 and another granted in 1867. Suit was brought under the 1867 patent. The 1866 patent showed, without claiming, what was claimed in the 1867 patent. Defendant claimed that the 1867 patent was therefore void. It was a fact that the 1867 patent was applied for before the 1866 patent was issued, but that fact did not enter into the decision of the Judge in sustaining the 1867 patent. He sustained the 1867 patent on the broad ground that a later patent to the same inventor may claim what is described but not claimed in his earlier patent; saying:

> "But conceding that the invention claimed in the patent of 1866
> 'is within the scope of the patent of 1867 as one of the means
> 'adopted and intended to be used in effectuating the method claimed
> 'in that patent, is the patent of 1867 therefore void?
>
> "The scope of a patent must be determined by its claim, and it
> 'does not necessarily cover all the descriptive matter in the specifi-

'cation. The office of the specification is to describe the invention 'claimed in such full, clear, and exact terms that any one skilled in 'the art to which it appertains can make and use it, and thus that 'it may be available to the public after the expiration of the patent. 'When the invention consists of a mechanical combination it is not 'only proper but requisite to describe the combination and arrangement of its component parts, the purpose for which it is to be used, 'the mode of its operation, and its relation to other mechanism with 'which it is intended to co-operate."

"This mechanism may be indispensable to the operativeness of 'the combination, but it does not constitute a part of the invention 'unless it is embodied in the claim. In *Forbush* v. *Cook* (2 Fish. '669), Mr. Justice Curtis says:

> 'If inclined wires are necessary to the action of the combination specified, so are many other parts of the machine, and all parts necessary to the action and combination specified might be said to enter into the mode of combining and arranging the elements of the combination, but need not be and ought not to be included in the combination claimed.'

"Can there be any doubt, then, that any one might lawfully 'practice the method of rotating a capstan described in the patent 'of 1866, simply substituting other mechanism for the combination 'therein claimed, or what is the same, they forming a new combi'nation by discarding some of the elements of the patented one? 'And why? Because only the combination claimed, and not the 'integral method described, is covered by the patent."

"With this limitation of the scope of the patent of 1866, might 'not a valid patent be subsequently granted, and that of 1867, for 'an integral method, of which the invention claimed in the first 'patent is one of the elements? I know of no sufficient reason 'why this may not be. The patents are incompatible. In a pat'entable sense their subjects are different, and hence they do not 'cover the same invention. It is well settled that mechanical device 'adopted and intended to be used in combined connection with 'other devices may be patented by itself, and that the combination 'of which it is a constituent part may also be separately patented. 'For what reason? Because both patents do not cover the same 'invention. Upon the same principle, if the complainant had built 'an engine of novel construction, describing it as specially fitted 'and intended for use in his method of rotating a capstan, he might 'patent it alone, and he might also obtain a patent for his method 'as a whole, describing his previously patented engine as one of its 'component parts."

"I am therefore of the opinion that the patent of 1867 is not in-'validated by reason of anything contained in the patent of 1866."

"These views are not impugned by the cases referred to in 'the argument as I understand them. A brief reference to two of 'them as representing the whole class to which they belong will 'sufficiently illustrate this."

"The fundamental principle of all these cases is that two patents 'for the same invention can not coexist, and that where two are 'issued to the same person the last one is void."

"In *O'Reilly* v. *Morse* (15 How. 63), the order of the patents in 'this case is inverted. Morse had obtained a patent broadly cover-'ing his whole invention. He afterward obtained a patent for a 'new arrangement or combination of the telegraphic mechanism by 'which the electro-galvanic current might be passed along the 'whole line without interruption by the local circuits."

"The court held the latter patent to be valid, saying:

> 'Nor can its validity be impeached upon the ground that it is an improvement upon a former invention for which the patentee had himself already obtained a patent. It is true that under the Act of 1836, section 13, it was in the power of Professor Morse, if he desired it, to annex this improvement to his former specification, so as to make it from that time a part of the original patent. * * * * * Nor is he bound in his new patent to refer specially to his former one. All that the law requires of him is that he shall not claim as new what was covered by a former invention, whether made by himself or any other person.'

"The evident reference here is to the scope of the two patents 'under consideration, and its import is that although Morse might 'have included in his first patent the arrangement or combination 'described in his second patent, yet, as it was not claimed in the 'former and was not therefore covered by it, he might make such 'arrangement the subject for a new claim and obtain a patent for it."

"In *Suffolk Co.* v. *Hayden* (3 Wall. 315), a patent for an inven-'tion which was described but not claimed in a previous patent was 'sustained upon the ground that the invention, although described, 'was not covered by the first patent, and this omission to include it 'did not operate as an abandonment of the improvement to the 'public."

"There is another feature in the case which brings it into notable 'resemblance to the present case. Before the second patent above 'referred to was granted an application by the same inventor was 'on file in the Patent Office for patent for improvements in the 'interior arrangements of an elongated trunk, previously in use for 'cleaning cotton, among others in the screen. Pending this appli-'cation he applied for a patent for the improvements in the screen, 'in both the specifications filed similarly describing this improve-'ment. A patent was granted upon this application, and sometime 'afterward a patent upon the original application. In reference to 'these two patents the court says that if they are for the same im-'provement the last one issued, and not the first, is void, obviously 'not for the reason that the description in both specifications was 'the same, but that the allowance of the last patent was futile, and 'that the original application for it was superseded and abandoned 'by the successful application for the first."

"But the court says further that the last issued patent does not 'appear to be for the same improvement covered by the first, but 'for a combination with it of other devices, thus clearly implying 'that the patent is good."

"Now, these cases with others of like character establish—

'1. That of two patents for the same invention the one last 'granted is void, although it may have been first applied for.

'2. Whether two patents cover the same invention must be 'determined by the tenor and scope of their claims, not by the 'description in the specifications.

'3. That separate patents for several parts of the same invention 'may be granted, although the whole invention is fully described in 'each of them to explain the purpose and mode of operation of the 'parts covered by the claims in such patents.

'4. That the connection or combination of a patented device or 'improvement with other devices may be the subject of a valid sub-'sequent patent."

* * *

In *Graham* v. *McCormick*, 11 Federal Reporter, 859, the patent in suit was issued in 1868. Graham took an earlier patent showing but not claiming what was claimed in this 1868 patent. The claims in this 1868 patent had been made in the application for an earlier patent but being rejected they were erased therefrom.

The application for the 1868 patent was made later than the application for the earlier patent, but before the earlier patent issued: this fact, however, in no wise entered into the discussion of the Judges, who say:

"It is insisted further by the defendants that the plaintiff's patent
'is invalid because the first application for a patent included the
'invention which is the subject of the two claims in controversy
'covered by the patent of 1868; and because that invention was
'not allowed in a previous patent, but the previous patent was
'issued for other claims, that the second patent, of 1863, is inoper-
'ative. And it is said that instead of there being a new patent
'issued in the case there might have been a reissue of the original
'patent; and it is also insisted that the second patent was issued
'for something in addition to what was claimed in the previous pat-
'ent, which claim was rejected, and the second patent is invalid on
'that account."

"Admitting the facts to be as stated by the defendants, is the
'conclusion drawn from them correct? We think it is not. It was
'not a proper case for reissue. There was no defective or insuffi-
'cient specification. The inventor had not claimed more than he
'had a right to claim as new. The case as it is put is one where
'there was a description of an invention which was not claimed, the
'claims in controversy here having been withdrawn, and where we
'must assume that the person was entitled to a patent, inasmuch as
'the Office subsequently granted him a patent for the invention
'described. On general principles, we think that where a person
'has, within the meaning of the patent law, made an invention
'which he has described in specifications, including other matters
'of invention, for which last a patent has been issued, that he should
'not be precluded for that reason alone from applying for and ob-
'taining a patent for that which was not claimed in the first patent.
'The object of the patent law was to protect a party who made an
'invention which was useful, provided he complied with the terms
'of the law and a patent issued for the invention; and unless there
'is something in the law which declares a patent issued under such

'circumstances to be invalid, it is the duty of the courts to sustain 'a patent for an invention thus made."

* * *

In *Burton* v. *Greenville*, 3 Federal Reporter, 642, (Lowell, 1880.) the complainant took a patent for a lamp post, June 13, 1876. August 26, 1876, he applied for a patent on a design for a lamp post which was granted December 5, 1876. The earlier patent showed what the latter patent claimed and defendant made the point that the taking of the earlier patent operated as an abandonment. It will be noticed that, in this case, the latter patent was applied for after the issue of the earlier patent. Judge Lowell said:

"A question is made by the defendants, whether an inventor is 'not to be presumed to abandon his design when he exhibits it in 'the drawings of a mechanical patent. I do not see why this consequence should follow until the design has been in use for two 'years."

* * *

In *Hatch* v, *Moffett*, 15 Federal Reporter, 252, (Lowell, 1883.) an earlier patent to the same inventor *showed* what the latter patent—the one in suit—*claimed*. The earlier patent was dated Aug. 1, 1871. The latter patent was applied for Aug. 21, 1871, and granted July 16, 1872. It will be noticed that the latter patent was applied for after the issue of the earlier patent. The defendants claimed that the description in the earlier patent operated as an abandonment, and thereupon the court said:

"I am much inclined to think that the mere fact that a new article 'is shown in the drawing of a patent for a machine would of itself be 'an abandonment of the new article, which would properly be the 'subject of a different patent, until the statutory forfeiture of use for 'two years had been incurred."

* * *

It is believed that the foregoing *resume* of decisions includes every case in which the attempt was made to show that describing without claiming operates as such an abandonment that a described matter may not be claimed in a subsequent patent.

Every one of these decisions is opposed to any such doctrine and no case can be found where any doctrine to the contrary is enunciated.

The Commissioner, so far as he is able to find any support whatever, bases it upon the late reissue decisions. But those late reissue decisions wherever they touch the question at all, are directly opposed to the position taken by the Commissioner.

We quote below:

"It is not sufficient that the patent does not cover all that the 'patentee could have claimed if his specifications had come up to 'his invention. If he has invented or discovered something beyond 'his original specifications and claim, his course is not to endeavor 'to cover it by a reissue, *but to seek a separate patent for it.*"

"The statute authorizing a reissue was intended to protect against 'accidents and mistakes, and it is only when thus restricted that it 'can be regarded as a beneficial statute. If a patentee does not em-'brace by his specifications and claim all that he might have done 'and there has been no clear mistake, inadvertence or accident in 'their preparation, the presumption of law is that he has aban-'doned to the use of the public everything outside of them, or at 'least *has postponed any additional claim for further consideration.*"

Powder Co. v. *Powder Co.*, 4 Federal Reporter, 720, (725) Field, 1880.

"If he was the author of any other invention than that which he 'specifically describes and claims, though he might have asked to 'have it patented at the same time and in the same patent, yet, if 'he has not done so and afterwards desires to secure it, he is bound 'to make a new and distinct application for that purpose and make 'it the subject of a new and different patent."

"When a patent fully and clearly, without ambiguity or obscurity, 'describes and claims a specific invention, complete in itself, so that it 'can not be said to be inoperative or invalid by reason of a defective 'or insufficient specification, a reissue can not be had for the pur-'pose of expanding and generalizing the claim so as to make it em-'brace an invention not described and specified in the original."

James v. *Campbell*, 21 O. G. 337, Supreme Court, 1882.

"Having obtained a patent for his specific device and combina-'tion, if he afterward wished to claim the general combination, and 'had not already abandoned it by taking a narrower patent, he was 'bound to make a new application for that purpose."

> "Patentees avoid doing this when they can and seek to embrace 'additional matters in a reissue in order to supersede and get possession of the rights which the public, by lapse of time or other 'cause, have acquired in the mean time."
>
> *Ibid.*

The last two quotations are from the identical case on which the Commissioner of Patents bases his present position. It is to be observed that they all clearly make the distinction that while matter described in an original patent can not subsequently be claimed in a *reissue*, it may be subsequently claimed in *an original* patent.

Before proceeding to a specific consideration of *James* v. *Campbell*,—the case on which the Commissioner bases his position—let us refer to certain rules of construction which ought by this time to be well understood:—

> "It is the office of all adjudication to apply the principles of the 'law with nice discrimination to the ever-varying circumstances of 'different states of fact, and not to rely upon former decisions as 'absolute precedents when the facts are not the same. But this is 'peculiarly and eminently true in the administration of the patent 'law."
>
> *Preface to Third Edition of Curtis on Patents.*

> "General observations by a judge or a court in deciding a case, 'must always be read in view of the facts of the case that was '*sub judice* and are not necessarily authoritative *ex vi termini* in 'another case where the facts are not the same."
>
> *Wilson* v. *Coon*, 6 Federal Reporter, 611, Blatchford, 1880.

> "What was said is to be understood by reference to what it was 'spoken of."
>
> *Hill & Prentice* v. *Com'r of Patents*, Mss. Wheeler, Jan. 28, 1884.

JAMES *v.* CAMPBELL—SPECIFICALLY.

The Commissioner supposes that he finds warrant for his position in language to be found in the latter part of *James* v. *Campbell*.

He has utterly misconceived the purport and meaning of the entire latter part of that decision. That latter part not only does not say, or mean to say, that an inventor may not claim in his later patent what he simply describes in his earlier patent, but it says that he *may;* and points out the distinction between doing this by an *original* and doing it by a *reissue*, condemning the latter and endorsing the former.

Let us begin our examination of this part of the decision by quoting two parts of the decision, one of which quotations is found before we reach this "latter part," and the other of which is found *in* this "latter part."

"If he was the author of any other invention than that which he 'specifically describes and claims, though he might have asked to 'have it patented at the same time and in the same patent, yet, if 'he has not done so and afterward desires to secure it, he is bound 'to make a new and distinct application for that purpose and make 'it the subject of a new and different patent."

"When a patent fully and clearly, without ambiguity or obscu'rity, describes and claims a specific invention, complete in itself, so 'that it can not be said to be inoperative or invalid by reason of a 'defective or insufficient specification, a reissue can not be had for 'the purpose of expanding and generalizing the claim so as to 'make it embrace an invention not described and specified in an 'original."

James v. *Campbell,* 21 O. G. 337, Supreme Court, 1882.

"Having obtained a patent for his specific device and combina'tion, if he afterward wished to claim the general combination, and 'had not already abandoned it by taking a narrower patent, he was 'bound to make a new application for that purpose."

"Patentees avoid doing this when they can and seek to embrace 'additional matters in a reissue in order to supersede and get pos'session of the rights which the public, by lapse of time or other 'cause, have acquired in the mean time."

Ibid.

These two quotations expressly say that an inventor *may* claim in his later original patent what he simply describes in his earlier patent.

Unless we are to adopt the impossible assumption that the Supreme Court is so daft as to twice state a proposition in a single case and then flatly contradict it within the limits of the same case, the language on which the Commissioner relies must be reconcilable with the language of the two foregoing quotations.

It is entirely reconcilable therewith and that in a manner which entirely disposes of the claim made by the Commissioner.

This "latter part" of *James* v. *Campbell*, begins with the following language:

> "The last claim—to wit: 'The employment and combination of 'a post marking device with a postage stamp canceling device, both 'being operated by one and the same handle, for the post-marking 'of letters, envelopes or packets, and for the cancelation of the 'postage stamps thereon with indelible or other ink, in a manner 'herein substantially described and set forth,' may admit of *two* '*constructions.* It may either amount to a claim for a combination 'of *any kind* of device for stamping and blotting, or for a combina-'tion of the *particular* device described in the patent. In as much 'as these substituted devices, as we have already shown, embrace 'new devices not described in the original patent, the claim is too 'broad in either of its aspects to be advanced in a reissue of that 'patent unless the patentee was really the inventor of the *general* '*combination* of such devices in a double stamp, and was entitled to 'patent a claim therefor in such reissue. We have seen that his 'original patent was for a *specific* blotting device and for the com-'bination of such *specific* device with a post-stamping device in the 'same instrument. Could he in a reissue of the patent lawfully 'make the *broad* claim of the combination of *any and all* devices 'for blotting and post-stamping at one and the same time, in one 'and the same instrument?"

There can be no doubt as to what question the court is entering upon in using the language just quoted. It is discussing the *construction of the claim.*

The discussion continues upon this same point to the end of the decision. Complainant (below) is contending for a *broad* construction of claim; the court proceeds to show that he must have a *narrow* construction. Complainant is contending for a construction covering *any* combination of a stamper and blotter in one instrument, such a construction being necessary in order to enable him to reach defendant's device. The court finds that the claim must be limited to complainant's *specific* device, basing its finding principally upon complainant's earlier, 1859 and 1862, patents, both of which (showed and) *claimed* such combinations thus.

(The 1859 patent.) "The blotter *J* connected or attached to 'the main part of any Post-Office post-marking stamp, &c."

(The 1862 patent.) "I also claim the combination of the 'canceling stamp *c* and the post-marking or rating stamp *D*, with 'the cross-piece *B*, substantially as and for the purposes herein 'described and set forth."

Toward the close of the decision the Commissioner says:

"The case then upon the patent is *narrowed* down to the claim 'of the *specific* device of the blotter as described and claimed in the 'original patent, and the combination thereof with the post-marking 'devices in one instrument by means of the cross-bar."

The entire latter part of this decision, including all that the Commissioner relies upon, is occupied with this *construction of the claim* in complainant's later patent, in view of the *claim* made in complainant's earlier patents. Keeping this fact in view the entire "latter part" of the decision not only affords no support for the Commissioner's position, but it expressly overthrows it by using, *as a part of the same discussion*, the following language:

"Having obtained a patent for his *specific* device and combination, if he afterward wished to claim the *general* combination, and 'had not already abandoned it by taking a narrower patent, *he was 'bound to make a new application for that purpose.* Patentees avoid 'doing this when they can and seek to embrace additional matters 'in a *reissue* in order to supersede and get possession of the rights 'which the public, by lapse of time or other cause, have acquired 'in the mean time."

It overthrows the Commissioner's position by pointing out that while an inventor may not, *in a reissue*, claim the thing simply described in his earlier original, he may claim it in his later *original patent.*.

This review of the precedents not only fails to support the Commissioner, but distinctly and squarely shows that Hill & Prentice's claim is a right and proper one.

ON PRINCIPLE.

"Forfeitures and abandonment are not favored. They must be 'clearly made out."

Singer v. *Braunsdorf*, 7 Blatchford, 521 (532) Blatchford, 1870.

"Lapse of time does not *per se* constitute abandonment. . . 'We know of no mere period of time which ought *per se* to deprive an inventor of his patent."

R. & E. Manf. Co. v. *Mallory*, 5 Fisher's Patent Cases, 632, (643) Woodruff & Shipman, 1882.

"This abandonment or dedication, too, operates in the nature 'of a forfeiture of a right which the law does not favor and which 'should be made out beyond all reasonable doubt."

Pitts v. *Hall*, 2 Blatchford, 230—1 Fisher's Patent Reports, 441 (450) Nelson & Conklin, 1851.

"This is a matter that may be proved but it is not to be presumed."

Machine Co. v. *Tool Co.*, 4 Fisher's Patent Cases, 284, (299) Shepley, 1870.

"Abandonment itself is a fact and not a conclusion of positive 'law, statutory or common, arising from any prescribed state of 'facts."

Sprague v. *Adrian*, 3 Banning & Arden, 124 (125) Wheeler, 1877.

Why should the disclosure of an invention in a patent work abandonment (at least until after the disclosure has lasted two years) when the law expressly permits an inventor not only to disclose his invention to the public otherwise, but permits that public to work the invention freely for two years without invalidating his right to a patent?

When the disclosure is made in a patent, it is made in such a way that the public simply *may* work it. But the law goes further than that and says that though the public *actually do* work the invention for two years that shall not bar the inventor's right.

The court may be inclined to ask why these inventors waited from the date of the issue of their patent of Sept. 3, 1878, until March 30, 1880, before filing their second application. In our view of the case this is not a pertinent question, but the fact is—disclosed, we believe, by the record in evidence—that almost immediately after the issue of the patent of 1878, it went into interference in a way and manner which naturally prevented these inventors from making the second application until the time they did make it.

Conclusion.

The *statute* gives no warrant for the position of the Commissioner. The *precedents* all support the exact opposite views.

The *prinicples* to be evolved, from all cases touching abandonment, are opposed to the position of the Commissioner. The principle to be drawn from the analagous doctrine of two years' public use is opposed to the position of the Commissioner. The position of the Commissioner is not only without warrant of any possible kind, but is opposed to the statute, to all the precedents, and to all principles.

WM. EDGAR SIMONDS,

Counsel for Complainants.

114-133

Office Supreme Court U. S.
FILED.
FEB 4 1885
JAMES H. McKENNEY,
CLERK.

Supreme Court of the United States

OCTOBER TERM, 1884.

THE DETROIT CITY RAILWAY,
Plaintiff in Error,
vs.
JACOB GUTHARDT,
Defendant in Error.

No. 923.

Error to Supreme Court of Michigan.

Motion to Dismiss Writ of Error for Want of Jurisdiction,

AND

BRIEF OF HENRY M. DUFFIELD,
Counsel for Defendant in Error.

DETROIT:
POST AND TRIBUNE BOOK AND JOB PRINTING ESTABLISHMENT.
1885.

SUPREME COURT of the UNITED STATES.

OCTOBER TERM, 1884.

THE DETROIT CITY RAILWAY, *Plaintiff in Error.* VS. JACOB GUTHARDT, *Defendant in Error.*	Error to the Supreme Court of the State of Michigan.

To JOHN C. DONNELLY, Esq.,
Attorney for Plaintiffs in Error.

TAKE NOTICE, That on Monday, the 23d day of February, proximo, at the opening of Court, or as soon thereafter as counsel can be heard, on behalf of said defendant in error, I shall move this Honorable Court to dismiss the writ of error issued in this cause, for the following reasons:

First—Because the Supreme Court of the United States has no jurisdiction of the case, in that the record does not show that any federal question was involved in the case in the State Court.

Second—Because the Record does not show that in the suit in the State Court there was drawn in question either the validity of a treaty or statute of, or an authority exercised under the United States, or laws of the United States; nor was there especially set up or claimed under the constitution, or any treaties or statutes of, or commission held, or authority exercised under the United States, any right, title, privilege or immunity.

Third—Because in the State Court no right, under the constitution or laws of the United States, was claimed by the plaintiff in error.

Also, take notice, that at the same time and place, and in union with the foregoing motion, I shall, on behalf of the defendant in error, further move the Court to affirm the judgment and decision of the Supreme Court of the State of Michigan, upon the ground that, although the Record may show that this Honorable Court has jurisdiction, it is manifest that the question on which the jurisdiction depends is so frivolous as not to need further argument.

This motion will be founded upon the Record of this case.

Take notice, also, that you are herewith served with a copy of the brief of the counsel for the defendant in error, to be used in this cause.

The facts upon which this motion is based, appear in the following abstract of the Record :

ABSTRACT OF RECORD.

The action was replevin for 61 horses in the barn of the Detroit City Railway, at the corner of Antoine and Woodbridge streets, in the City of Detroit, Michigan, of the value of $5,000 and upwards.

The plea was the general issue.

The cause was tried before the Superior Court of Detroit, without a jury. At the written request of the defendant, that Court made and filed the following finding of facts :

1. That the plaintiff is a corporation organized May, 1863, under the provisions of Chapter 76, of the Comp. Laws of Michigan of 1871, or such portions thereof as were in force at the time of such organization, and was and is now operating a street railway in the City of Detroit, in accordance with the provisions of said chapter, and by permission duly granted by the City of Detroit.

2. That the defendant was and is the Receiver of Taxes for the City of Detroit.

3. That on November 16, 1882, said defendant made a legal demand upon the plaintiff of the taxes hereinafter specified, and the plaintiff refused to pay the same; that thereupon defendant levied upon the property described in the writ of replevin, claiming there was due to the City of Detroit from the plaintiff the sum of $2,621.91 for the city taxes, which had been spread upon the general tax rolls of said City for the year 1882, and the sum of $104.87 added as Receiver's charges. Attached to this finding is a copy of that portion of said tax rolls, containing the assessment and levy of taxes in question, showing the form, manner and amount of said tax levy. That said assessment roll was duly made and certified to by the Assessor, and confirmed by the Board of Review, and the Common Council, in accordance with the provisions of the charter of the City of Detroit. That said property was levied upon and taken from the possession and control of the said plaintiff, who was the owner thereof, for the purpose of enforcing the payment of said tax and charges.

4. That upon the seizure of said property the plaintiff inquired of the defendant whether, if the amount of the tax which was described in said roll as a tax for personal property was paid he would release the

property seized. The defendant refused to accept the said personal tax, demanding the payment of the full amount of the tax contained in said rolls, and amounting to the sum of $2,621.91, and the sum of $104.87 added by the Receiver.

5. That thereupon plaintiff brought replevin for the property seized.

I find as a conclusion of law from the foregoing facts that the plaintiff is entitled to recover.

J. LOGAN CHIPMAN,
Judge.

The defendant in error duly excepted to the conclusion of law above stated, and carried the case by a writ of error to the Supreme Court of the State of Michigan, which is the State Court of last resort.

I also attach a copy of the brief of counsel for plaintiff in error (marked "A,") in which no claim of right is made under any statute or authority of the United States.

The Supreme Court of the State of Michigan reversed the judgment of the Court below, and entered judgment in favor of the defendant in error for the full amount of the tax claimed, and costs.

A motion for a rehearing was made and denied, but it will not be considered on this motion as it forms no part of the Record.

Lagrange vs. Chouteau, 4 Pet. R., p. 287.
Gibson vs. Chouteau, 8 Wall. R., p. 314.

Subsequent to the rendering of this judgment by the Supreme Court of the State, plaintiff in error moved the Supreme Court of Michigan for a certificate that a federal question was involved in the case. This motion was properly denied by the Court of the Supreme Court of the State of Michigan, no federal question having been raised by the plaintiff in error in said Court.

BRIEF.

The present constitution of the State of Michigan took effect January 1st, 1851. Article fifteen, section one, is as follows:

"Corporations may be formed under general laws, "but shall not be created by special act, except for "municipal purposes. All laws passed pursuant to this "section may be amended, altered or repealed." * * *

Howell's Annotated Statutes of Michigan, Vol. 1, p. 64.

The statute under which plaintiff in error was organized, was passed February 13, 1855.

Sections 22 and 31 are the only portions material to the question involved here.

They are as follows:

"SEC. 22. Each and every railway company formed "under this act, shall pay to the Treasurer of the State "of Michigan, an annual tax at the rate of one-half of "one per cent. on the whole amount of capital paid in "upon the capital stock of said company, which said "tax shall be estimated upon the last preceding report "of said company, and shall be paid to the said Treas-"urer on the first Monday of July in each year, and shall "be in lieu of all other taxes upon all the property of "said company."

"SEC. 31. The Legislature may at any time alter, "amend, or repeal this act; but such alteration, amendment, or repeal shall not operate as an alteration or "amendment of the corporate rights of companies formed "under it, unless specially named in the act so altering "or amending this act, nor shall the dissolution of any "such company take away or impair any remedy given "for or against said corporation, its stockholders, or "officers for any liability which shall have been previously incurred."

Howell's Annotated Statutes, Vol. 1, pp. 906, 907.

Section 22, above quoted, being section 3516 of Howell's Annotated Statutes, was repealed by the Legislature of the State of Michigan on the 13th day of March, 1882.

Howell's Annotated Statutes, p. 1258, and Session Laws containing Public acts of 1882, p. 4.

At the session of the Legislature of the State of Michigan last cited, a new general tax law of the State was enacted, approved, and took effect March 14, 1882, containing among other provisions, the following:

"SEC. 1. The People of the State of Michigan "enact that all property within the jurisdiction of this "State not expressly exempt, shall be subject to taxation." * * *

"SEC. 4. All corporate property, except where "some other provision is made by law, shall be assessed "to the corporation as to a natural person in the name of "the corporation. The place where its principal office "in this State is situated, shall be deemed its residence."

Howell's Annotated Statutes, Vol. 1, pp. 1265 and 1266.
Session Laws of 1882, p. 7.

The City of Detroit duly assessed the tax in question, and, in default of the payment thereof by the plaintiff in error, levied upon the property described in the writ of replevin, under the authority of the following provision in the Charter of the City of Detroit:

"(§ 246.) SEC. 13. On and after the first day of "August in each year, and at any time until the taxes "mentioned in this section are paid, it shall be the duty "of the Receiver of Taxes, and the clerk or subordinates "in his office designated by him for that purpose, to collect all unpaid taxes, duly assessed against any property or value other than real estate, and if necessary "the said Receiver and said clerks and subordinates, "under the direction and in the name of the Receiver shall "have power to levy upon and sell at public auction "the personal property of any person refusing or neglecting to pay such tax." * * *

Charter of the City of Detroit, as amended by Act No. 224, Local Acts Michigan Session of 1879, p. 263.

By the following section of said Charter, the same is declared to be a public act.

"(§ 763.) SEC. 15. This shall be deemed a public act, "and shall be construed benignly and favorably for any "beneficial purpose therein intended."

Charter of the City of Detroit, p. 463, Sec. 763.
Michigan Session Laws of 1857, p. 73.

To test the validity of the tax plaintiff in error sued out a writ of replevin.

A copy of the opinion of the Court is sent up with the Record, but is not legally a part thereof.

Williams vs. Norton, 12 Wheat. R., p. 117.
Moore vs. Mississippi, 21 Wall. R., p. 636.

If for any reason it should be so considered,

McManus vs. O'Sullivan, 91 U. S. R., p. 578.
Murdock vs. Memphis, 20 Wall. R., p. 590.

it fails to show that any federal question was involved in the State Court.

It is clear from a perusal of the brief "A," that the plaintiff in error did not claim in the State Court any constitutional *want of power* in the Legislature to pass the act complained of, but contended solely that under a proper construction, the repealing act and the new tax law did not apply to corporations organized before the dates of their passage.

I.

This Court will not sustain the writ of error in this cause, because there is no federal question expressly raised or necessarily involved in the decision of the case in the State Court.

Even before the case of

Crowell vs. Randall, 10 Pet. R., p. 368.

the doctrine contended for by the defendant in error was enunciated by this Court, but in the last named case, after a full review of the prior decisions by Mr. Justice Story, the Court reaffirmed the interpretation which they had constantly maintained, and enunciated the following proposition: ' That to bring a case within the 25th section of the Judiciary Act, it must appear upon the face of the Record; (1) That some one of the questions stated in that section did arise in the State Court; (2) That the question was decided by the State Court as required in the same section; (3) That it is not necessary that the question should appear on the Record to have been raised and the decision made in direct and positive terms *ipsissimis verbis*, but that it is sufficient if it appears by clear and necessary intendment that the question may have been raised and must have been decided in order to have induced the judgment; (4) That it is not sufficient to have shown that a question might have arisen or been applicable to the case unless it is further shown on the Record that it did arise and was applied by the State Court to the case.

This decision has been followed by this Court in numerous cases, which hold that it must appear from the Record of the case, either in express terms or by clear and necessary intendment, that one of the questions which the Supreme Court has jurisdiction to re-examine and decide was actually decided by the State Court.

Medbury vs. State, 24 How. R., p. 413.
Christ Church vs. Philadelphia, 20 How. R., p. 26.
Murdock vs. Memphis, 20 Wall. R., p. 590.
Smith vs. Adsit, 16 Wall. R., p. 185.
Commercial Bank vs. Buckingham, 5 How. R., p. 317.
Ocean Ins. Co. vs. Polleys, 13 Pet. R., p. 157.
Edwards vs. Elliott, 21 Wall. R., p. 532.
Smith vs. Hunter, 7 How. R., p. 738.
Klinger vs. State, 13 Wall. R., p. 857.
Walker vs. Villavase, 6 Wall. R., p. 124.

The allegation of such a decision in the petition for the writ of error is not sufficient, for that petition forms no part of the Record.

Morefield v. Chaffee, 91 U. S. R., p. 690.

It seems too clear for argument that under the decisions cited, the writ of error should be dismissed.

All that appears upon the Record is a claim by the plaintiff in error that a tax which was imposed on it was illegal and void. Nowhere in the Record is there any claim by the plaintiff in error that the act imposing the tax complained of is obnoxious to any provision in the constitution of the United States. It might be that the tax was void because of its conflict with the provisions of the State constitution. And such has been the rule of this Court in cases where the general objection of illegality and unconstitutionality has been raised on the Record.

In the case of

Hurley v. Street, 14 Wall. R., p. 85.

one of the defences of the plaintiff in error was that "the "law authorizing the tax sale was unconstitutional and "void." But this Court held that such objection did not raise a question under the 25th section of the Judiciary Act, and in dismissing the case called the attention of the bar to the fact that much expense would be saved to suitors, if, before they advised them to appeal from the decisions of the highest State Court to this Court, they would see that the case was one of which this Court had cognizance on appeal. And in an earlier case of

Porter v. Foley, 24 How. R., p. 415.

the objection by the plaintiff in error to a deed under an act of the Assembly of Kentucky to sell the real estate of miners "because said act and supplement were unconsti- "tutional and void," was construed by this Court as having reference to the validity of the act of the Legislature of Kentucky, not as contrary to any provision of the Constitution of the United States, but as raising the question whether the Legislature had the power under the constitution of that State by general or special enactment to authorize the sale of real estate of infants. In each of these decisions the case of the plaintiff in error was much stronger than in the case at bar, for in the case at bar there is an entire absence from the Record and from the briefs of counsel of any claim that the act of the Legislature imposing the tax in question is void. Their contention in the State Court was that a proper construction of the act in question showed that it was not the *intention* of the Legislature to make it applicable to existing corporations.

Again, whether a case under the 25th section of the Judiciary Act might have been made and decided upon the facts appearing on the Record, is immaterial. It clearly appears *that no such case was made*, and in order to give this Court jurisdiction, the Record must show that the point was brought to the attention of the State Court and decided by it. It is not sufficient that the point was in the case and might have been raised and decided.

The Victory, 6 Wall. R., p. 382.
Hamilton Co. vs. Massachusetts, 6 Wall. R., p. 632.
Maxwell vs. Newbold, 18 How. R., p. 511.
Smith vs. State, 18 How. R., p. 71.
Crowell vs. Randell, 10 Pet. R., p. 368.
Farney vs. Fowler, 1 Black, R., p. 350.
Caperton vs. Bowyer, 14 Wall. R., p. 216.
M'Kenny vs. Carroll, 12 Pet. R., p. 66.
Hoyt vs. Sheldon, 1 Black, R., p. 518.
Coons vs. Gallagher, 15 Pet. R., p. 18.
Worthy vs. Commissioners, 9 Wall. R., p. 611.
Salomons vs. Graham, 15 Wall. R., p. 201.
Steines vs. Franklin County, 14 Wall. R., p. 15.

In

Grand Gulf R. & B. Co. vs. Marshall, 12 How. R., p. 165,
and Calcote vs. Stanton, 18 How. R., p. 233.

the Court say, if the party omits to claim in the State Court a right to which he is entitled under the constitution or laws of the United States, there is no reason for permitting him to harass the adverse party, by an appeal to this Court when, for anything that appears in the Record, the judgment of the State Court might have been in his favor, if its attention had been drawn to the question.

Again, if this Court will examine the opinion of the Supreme Court of the State, reported in 51 Mich. R., p. 180, as it is intimated it may do in

Murdock vs. Memphis, and
McManus vs. O'Sullivan, above cited,

it will appear to its satisfaction that the judgment of the State Court was based upon some independent ground and not on any federal question. If this be the case then this Court will not take jurisdiction on writ of error.

Klinger vs. State, ubi, sup.
Commercial Bank vs. Rochester, 15 Wall, R., p. 639.
Ins. Co. vs. Treasurer, 11 Wall, R., p. 204.
Steines vs. Franklin Co., ubi. sup.
Gibson vs. Chouteau, 8 Wall, R., p. 314.
Vose
Cockroft vs. ~~Bowes,~~ 14 Wall. R., p. 5.

II.

If any federal question is necessarily involved it can only arise on the claim by the plaintiff in error that under its charter no rate of taxation other than that prescribed in section 22, above quoted, can be imposed on it unless it is expressly named in the act changing its rate of taxation.

Section 1 of Article 15 of the constitution above quoted, was the law of the State prior to the passage of the act under which the plaintiff in error is incorporated. It is not only *prior in tempore* but *potior in jure.* The same constitution also commands the Legislature to provide an uniform rule of taxation, as follows: "Sec. 11. The Legislature shall provide an uniform rule of taxation." * * *

Constitution of Michigan, Sec. 11, Art. 14.
Howell's Annotated Statutes, vol. 1, page 63.

The case, therefore, so far as the power of the Legislature to repeal section 22, and substitute therefor a different mode of taxation, falls within the decisions in

Tomlinson vs. Jessup, 15 Wall. R., p. 454.
Trask vs. Maguire, 18 Wall. R., p. 291.

See also,

Cooley on Taxation, pp. 55 and 56, and cases there cited.

The constitution is of course stronger than the statute, and controls it. The attempt by one Legislature to restrict or limit a subsequent Legislature in its exercise of the constitutional power of amendment or repeal to a particular mode or form of repealing or amending act, is as much a violation of the constitutional provision in principle as an attempt to provide perpetual immunity from taxation.

In

Miller vs. State, 15 Wall. R., p. 478,

a precisely similar constitutional provision in New York was construed by this Court, and in

Holyoke Co. vs. Lyman, 15 Wall. R., p. 45,

a similar provision in the revised statutes of Massachusetts was considered.

See also,

Railroad Co. vs. Maine, 96 U. S. R., p. 499.
Shields vs. Ohio, 95 U. S. R., p. 319.
Hoge vs. Railroad Co., 99 U. S. R., p 348.
And the Sinking Fund cases, 99 U. S. R., p. 700.

In the case last cited, the principle contended for by defendant in error in the case at bar, is recognized by Mr. Justice Bradley in his dissenting opinion,

See foot of page 749.

and also Mr. Justice Field, page 758.

For the reasons above stated, I submit that the writ of error should be dismissed.

HENRY M. DUFFIELD,
Of Counsel for Defendant in Error.

STATE OF MICHIGAN.

SUPREME COURT.

DETROIT CITY RAILWAY,

vs.

JACOB GUTHARDT.

"A."

BRIEF FOR PLAINTIFF.

Plaintiff is a corporation, owning and operating a street railway in the City of Detroit. It was incorporated in 1863, under the provisions of Chap. 76 of Comp. L. 1871.

The defendant is the Receiver of Taxes of the City of Detroit.

Under Sec. 22, of Chap. 76, the plaintiff paid a specific tax of one half of one per cent. on the paid-in capital. This amount was paid into the State Treasury and was in lieu of all other taxes.

At the special session of the Legislature in 1882, Section 22 was repealed.

Laws 1882, Act No. 6.

Thereupon the municipal authorities proceeded to tax the road, road-bed, rolling stock, and other personal property of plaintiff, for general municipal and local purposes, as set forth in the copy of the assessment roll contained in the record.

The defendant, acting for the city, demanded payment of the tax so levied, which plaintiff refused to pay, and thereupon the defendant levied upon a large amount of personal property of plaintiff, for the purpose of realizing the tax.

The company brought this action for the property, claiming that no valid tax could be levied against it as claimed by defendant.

The plaintiff denies the legality of the tax, for the following reasons:

1. That according to the provisions of section 31, Chap. 76, of Comp. L. 1871, (being the act under which the corporation was formed) the corporation was not in any way affected by the repeal of Sec. 22 of same Chap., as set forth in Act 6 of Laws of 1882, there being no reference in the repealing act to existing corporations already formed.

2. That regardless of the provisions of section 31, the mere naked repeal of section 22 did not subject existing corporations to general taxation, as was attempted by the municipal authorities in this case, and claimed this on the grounds:

a. That unless the repeal in express terms is made to apply to corporations already formed, it will only apply to and affect corporations to be formed in the future.

b. That upon the formation of a corporation, the general law as it then stood becomes the charter of the corporation. The right to be subject to specific taxation becomes a corporate right, or privilege or property. That in order to change or destroy this corporate right, privilege or property, the legislature can only do so by a specific amendment to the organic act. That in order to change the rule of taxation as to corporations existing, the different rule or manner of taxation must be made by an amendment of the organic act, or an independent act, which specifically refers to the classes and forms of corporations to be affected by the change.

c. That the Legislature never intended that this class of corporations should be taxed under the general tax law, inasmuch as the plan of taxation laid down in the general law is inapplicable to cases where the tracks and roadbeds of the corporation extend through various taxing districts.

And further, that the plan of taxation laid down in the city charter is wholly insufficient for the purposes of general taxation of corporate property, such as we have in this case.

It is further urged in behalf of the plaintiff that under the provisions of the city charter, no levy could be made on personal property for the collection of taxes on real estate, and the principal portion of the amount for which the property in this case was seized is assessed on real estate, etc.

I.

Section 31, of Chap. 76, contains the following:

"The Legislature may at any time alter, amend or repeal this act; but such alteration, amendment or repeal shall not operate as an alteration or amendment of the corporate rights of companies formed under it, unless especially named in the act so altering or amending this act." * *

This clause is unrepealed, and remains a portion of the law governing these companies, and

It is contended on behalf of the plaintiff, that this section of the act establishes a rule of construction for the amending act, No. 6, of Laws of 1882, and gives to it the same effect, as though it read as follows:

"That section two thousand four hundred and eighty two (2,482) of the Compiled Laws of 1871, being section twenty-two, of an act approved February 13, 1855, entitled an act to provide for the construction of train railways, be and the same is hereby repealed; provided, however, that the repeal of said section shall not affect corporations heretofore formed under this act."

Beyond doubt such a provision would limit the operation of the repealing act to future corporations, and as section thirty-one is permitted to stand, it certainly establishes a rule by which all amendments to the act are to be construed.

Statutory provisions similar to this are frequent, and have always been considered valid.

As to the effect that section thirty-one has upon the question, we contend that it is entirely competent for the Legislature to provide in any act a rule of construction by which the rights of parties may be determined.

Section 31, if valid as a rule of construction, when passed, is valid now. The act as amended must be read as a whole, and section 31 remaining a portion of the act, so long as it stands unrepealed, operates as a provision or exception attached to and limiting the operation of every amendment of the act which does not by express terms refer to existing corporations.

While it may readily be conceded that one Legislature cannot bind or estop a future Legislature by any action, yet it can clearly establish by enactment a rule by which future legislation upon the same subject matter may be construed, unless the future Legislature should provide a different rule. And this is most clearly shown in the matter of legislation with reference to corporations. As illustration, take the numerous cases where by general law the power to amend, alter or repeal acts of incorporation is reserved, and all future acts of incorporation are held to be construed by the general law, and the power, to amend or repeal, is by construction reserved in every future act of incorporation.

Angell and Ames Corp., pp. 797 and 798, 10 Ed.

We have precisely the same provision in this state, in the revised statutes of 1846, Title X, Chap. 55, sec. 20, and now sec. 20, of Chap. 130, Comp. L., 1871.

We think that the question of the validity and effect of Sec. 31 is settled in this state by the decision of this Court in the case of People v. Grand Blanc Plank Road Co., 10 Mich., 400.

The General Plank Road Act of 1851, which was adopted under our present Constitution, contains a provision precisely similar to the one in the Train Railway Act. The Court say :

"The general purpose of this section was to reserve "to the Legislature a power of amendment and repeal "by which the right of companies formed under it might "be affected or impaired without the consent of such "companies; and the clause relied upon in support of "the demurrer is but a restriction or modification of "these rights reserved by the previous general words; "and this restriction or modification was inserted solely "for the protection of such company. It is in substance "and effect, but a stipulation that the corporate rights of "such companies as may have been formed under this "general act shall not be affected to their prejudice, or "against their consent by any alteration of the general

"act not having express reference to the particular com-
"panies intended to be thus affected. In other words,
"that, to impair any right of, or impose any new obli-
"gations upon such company by alteration or amend-
"ment, the legislative will must be exercised, not
"generally, but with special and express reference to
"each particular company intended to be thus affected,
"that each company may in such a contingency, stand
"upon its own merits."

It is therefore contended that under this decision the repeal of section 22 does not change the rule of taxation as to the plaintiff.

II.

It is further contended on behalf of the plaintiff, that even though section 31, be disregarded, still the legislation of 1882, under which the municipal authorities levied the tax, is not of such a character as is required to change or repeal the corporate rights of corporation then in existence under the general law, and the reasons given, are:

1. That the mere repealing of a section of a general act of incorporation does not operate as an alteration, or amendment of the corporate rights or franchise of existing corporations.

2. That without the existence of the constitutional clause, which permits the alteration, amendment or repeal of general acts of incorporation, or some reservation to the same effect in the general act, the Legislature would be powerless to make any change in the general act so as to affect existing corporations, and therefore we conclude that in order to effect any change in the charter of a corporation, it can only be done in the manner pointed out in the constitution or clause reserving the power to alter,

amend or repeal ; and consequently in order to impose a different rule, or a higher rate of taxation on the plaintiff, it must be by means of a specific amendment or change of the organic act.

The general law of incorporation becomes the charter of each corporation formed under it, and in the absence of reserved power, the same becomes a contract between the corporation and the state, and no alteration or amendment can be made to it to the prejudice of existing corporations.

Knoop vs. Piqua Bank, 16 How., 369.
Ib. 416.
18 Ib., 380.
East Sag. vs. East Sag. Manf. Co., 19 Mich., Op. Campbell, J., 294.

The power reserved, and the manner in which that power is to be exercised, is pointed out in Section 1, Art. XV. of the constitution. It provides that "corporations may be found under general laws. * * * All laws passed *pursuant to this section* may be amended, altered or repealed."

As we above stated, the power to amend, so as to affect existing corporations, is created in the above section, and does not exist without it. We therefore conclude that the power must not be extended beyond the grant ; and that it can be lawfully exercised only in the manner pointed out, viz.: that if it is deemed wise to change the rule of taxation laid down in the general act, in order to affect it, it can only be done by amending the organic act and incorporating therein the different rule—and in express terms applying it to existing corporations.

In speaking of the manner in which changes in corporate rights are to be affected, this Court, speaking of manufacturing corporations, said :

"These companies are organized under the general mining and manufacturing law. Their corporate franchises are all derived from that. The Legislature could not lawfully give them except by general act. That statute is in effect this charter; and any amendments made to *that, whereby their functions become varied, would govern.* But there is no provision in the constitution which authorizes the Legislature *to take away the property* of corporations, and there can be no process whereby an independent statute * * * can be construed as an amendment of the corporation act.

* * * * * *

"If such a statute can be regarded as an amendment of the corporation law, the same would be true of an act which would divest a corporation of all its possessions. Amendments are not made in this way. The constitution requires them to be manifested by a publication of the parts of the law as amended so that no one can be misled by blind provisions. *Whatever amendments are made must be amendments of the organic law*, and not independent statutes. And while corporations may be subject to many of the general laws which regulate the conduct of all persons, the alterations of their corporate privileges cannot be made except in the way the constitution prescribes."

East Sag. Mf'g Co. v. East Saginaw, 19 Mich., 294.

We further call attention to the distinction pointed out by this Court in the case of

Bewick v. Alpena Harbor Co., 39 Mich., 705.

It is there stated that "there is an obvious difference between repealing a general statute under which corporations have been formed for definite periods, and abolishing the corporations already organized under it. Whatever power the Legislature may possess to forbid future incorporations, or to limit or prevent the future enjoyments by existing corporations of certain franchises, such a repeal would not necessarily either end or shorten the corporate existence, or destroy all corporate franchises."

We cite this in support of our proposition, that it requires more than the naked repeal of section 22 to abolish the right of existing corporations of being subject to specific taxation only.

We therefore conclude that even though section 31 be considered nugatory, still the legislation relied upon by the defendant was insufficient to change the rule and rate of taxation on existing corporations.

III.

It is further submitted that the scheme of taxation embodied in the general tax law of 1882 cannot be applied to corporations organized under the Train Railway Act.

It will be seen from an examination of the act that corporations formed under it may construct railroads many miles in length, and extending through more than one county, and lying in different taxing districts. In the City of Detroit, as will be seen from the record, the road of the plaintiff lies in many different wards. The portion of the road lying in each ward is separately assessed and a levy is made on that portion. Under this system, the company could pay the tax levied upon that portion of the road lying in one ward, and leave the amount in another ward unpaid.

Nor does the city charter contain any provision which make possible the taxing of this class of property; and we think that if any general tax can be levied, as attempted in this case, further legislation is necessary.

IV.

A large portion of the tax for which the levy was made by the defendant is assessed on the road and tracks of plaintiff. They are assessed as real estate. Under the charter of the City of Detroit no levy can be made on the personal estate to pay a real tax. As appears from the record, this matter was brought to the attention of the defendant, but he declined to release the property from the levy unless both the real and personal taxes were paid. Unquestionably the seizure was unlawful, and the plaintiff was entitled to bring replevin. Personal property cannot be seized and sold for real tax.

See City Charter, 1880, p. §§ 246 and 247.

We therefore submit that the judgment should be affirmed.

BRENNAN & DONNELLY,
For Plaintiff.

UNITED STATES
Supreme Court

OCTOBER TERM, 1884.

THE DETROIT CITY RAILWAY,
Plaintiff in Error,
vs.
JACOB GUTHARDT,
Defendant in Error.

No. 923.

Error to Supreme Court of Michigan.

Motion to Dismiss Writ of Error for Want of Jurisdiction,

AND

BRIEF OF HENRY M. DUFFIELD,
Counsel for Defend't in Error.

114-133

Supreme Court of the United States.

No. 923.

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Brief for Plaintiff in Error,

—ON—

MOTION TO DISMISS WRIT OF ERROR, ETC.

JOHN C. DONNELLY,
F. A. BAKER,
Counsel for Plaintiff in Error.

DETROIT:
JOHN F. EBY & CO., BOOK AND JOB PRINTERS.
1884.

Supreme Court of the United States.

THE DETROIT CITY RAILWAY,
Plaintiff in Error,
vs.
JACOB GUTHARD,
Defendant in Error.

Brief for Plaintiff in Error on Motion to Dismiss Writ of Error.

STATEMENT OF THE CASE.

The Detroit City Railway is a street car company, organized in May, 1863, under an act of the Legislature of the state of Michigan, entitled, "An Act to Provide for the Construction of Train Railways," approved Feb. 13, 1855.

1 Comp. Laws of Mich., of 1857, p. 679.
1 Comp. Laws of Mich., of 1871, p. 818.
1 How. Stat. of Mich., of 1882, p. 900.

At the time the corporation was organized, sections 22 and 31 of said act were as follows:—

"Sec. 22. Each and every railway company formed under this act shall pay to the treasurer of the State of Michigan an annual tax, at the rate of one-half of

Supreme Court of the United States.

THE DETROIT CITY RAILWAY,
Plaintiff in Error,
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1 How. Stat. of Mich., of 1882, p. 900.

At the time the corporation was organized, sections 22 and 31 of said act were as follows :—

"Sec. 22. Each and every railway company formed under this act shall pay to the treasurer of the State of Michigan an annual tax, at the rate of one-half of one per cent. on the whole amount of capital paid in upon the capital stock of said company, which said tax shall be estimated upon the last preceding report of said company, and shall be paid to the said treasurer on the first Monday in July in each year, and shall be in lieu of all other taxes upon all the property of said company."

"Sec. 31. The Legislature may at any time alter, amend, or repeal this act; but such alteration, amendment, or repeal shall not operate as an alteration or amendment of the corporate rights of companies formed under it, *unless specially named in the act* so altering or amending this act; nor shall the dissolution of any such company take away or impair any remedy given for or against such corporation, its stockholders or officers, for any liability which shall have been previously incurred."

In 1882 there was a revision of the general tax laws of the state, and at the same session an act was passed repealing section 22 of the train railway act quoted above.

Public Acts, 1882, p. 4.

In the repealing act no attempt was made to comply with Section 31. The Detroit City Railway was not named, nor was any other company named therein.

The city of Detroit, acting upon the theory that the repeal of Section 22 left the property of the company subject to general taxation, assessed the property of the company, and levied taxes against it for the year 1882.

To enforce the payment of these taxes the city, by Jacob Guthard, its Receiver of Taxes, seized sixty-one horses, the property of the company. The company sued out a writ of replevin against Guthard, upon which the horses were taken and restored to the company.

The affidavit for the writ of replevin, following the provisions of the state statute on the subject, alleges that the company is entitled to the possession of the horses; that the same were "unlawfully detained by the defendant," and that they had "not been taken for any tax, assessment or fine levied by virtue of any law of this state."

Exemplified Record, p. 8.
2 How. Stat., sec. 8321, p. 2052.

Issue was joined in the replevin suit on a declaration, alleging an unlawful detention of the property, and a plea thereto of the general issue.

Record, pp. 12, 13.
2 How. Stat., secs. 8337, 8339, p. 2055.

The issue so joined was tried before the court without a jury. The court made a special finding of facts, which under the practice in Michigan, has the same force and effect as a special verdict at the common law.

Adams vs. Champion, 31 Mich., 233.

The facts found are:

1. The corporate existence of the company under the act in question as above stated.

2. That the horses in question were seized by Jacob Guthard, the Receiver of Taxes, for general city taxes assessed against the company, and spread upon the general city tax rolls for 1882.

3. That the proceedings by which said taxes were levied were regular and in accordance with the provisions of the city charter.

Upon these facts the court found, as a conclusion of law, that the plaintiff was entitled to recover, that is, that its action of replevin was well brought.

Record, pp. 18, 19.

And a judgment was entered accordingly.

Record, p. 16.

Upon the record so made up, the case was removed by writ of error to the Supreme Court of the state. The case was argued in that court on the 21st day of June, 1883, and decided the next day.

The opinion of the court was delivered by Justice Cooley. The court held in substance, that the exemption from general taxation, provided by section 22, was not one of the "corporate rights" of the company, within the meaning of section 31, and, therefore, that the taxes in question were valid.

The opinion will be found in the *Exemplified Record, at pp. 24-26*, and in *51 Mich., 180*.

Judgment was entered against the company for the full amount of the tax.

Record, p. 27.

Pending a motion for a rehearing the judgment so entered was vacated, but, the rehearing having been denied, it was re-entered December 20, 1883.

Record, pp. 29, 30, 31, 32.

On January 2, 1884, counsel for the company entered a motion in the cause asking the Supreme Court of the state to certify upon the record that the federal question involved was raised by the counsel for the company at the hearing of the cause in that court.

Record, p. 34.

The motion so made was submitted January 8th, and denied January 9, 1884.

Record, pp. 35, 38.

It does not appear (except by the averments of the petition for the allowance of the writ) on what ground the court refused to enter such a certificate on the record.

They could not have done so on the ground that the federal question involved was not raised at the hearing, for in point of fact it was raised, and the court admits it, in the opinion filed.

The court says:

"Different views may be taken of section 31, and were taken or suggested at the argument. It may be regarded as a contract between the state and the corporations limiting the power of the state for their protection so long as it remains in force, or as a stipulation in respect to the method in which legislation affecting them shall be adopted while it is allowed to stand, or as a legislative rule for the construction of subsequent legislation."

Record, p. 25.

The court continues:

"It is not important which one of these views is taken; for if to be taxed according to the provisions of section 22 is one of the corporate rights of these companies, within the meaning of section 31, as plaintiff contends it is, then they must be taxed under that section while section 31 remains in force, or they cannot be taxed at all."

Record, p. 25½

I.

The provision that no alteration, amendment or repeal should effect the corporate rights of companies previously organized unless they were specially named, is a contract between the companies and the state within the meaning of the constitutional provision that no state shall pass any law impairing the obligation of contracts.

1. The reservation of a power to amend, alter or repeal does not make the charter of a corporation any the less a contract between the state and the corporation.

The contract is not the same, but it is still a contract.

The state has no power to change the contract of incorporation except by the exercise of the power reserved, and if the power reserved is limited in any way, or it is stipulated that it shall be exercised in a specified manner or method, then such limitations or stipulations are essential parts of the contract, and as such binding on the state.

In *Miller v. State 15 Wall., 478*, it appeared that a power to amend, alter or repeal was reserved by the constitution of New York, by the general law of the state relating to corporations, and by the general railroad act under which the company concerned was organized.

In the opinion of the court delivered by Mr. Justice Clifford we find the following (p. 492.):

"Undoubtedly the powers and privileges of the railroad company in this case are the same as they would have been if the company had been incorporated by a special act, and it may also be conceded that the charter, when the articles of association were filed in the office of the Secretary of State, *became an executed contract* subject to the restrictions ordained by the constitution of the state, and to the reservations contained in the general law of the state relating to corporations, and also in the general railroad act which, it is admitted, prescribes and defines the powers and privileges of the railroad company."

In *Tomlinson vs. Jessup, 15 Wall., 454*, immunity from taxation was held to be within the power reserved, because it was "a part of the contract with the government."

2. It cannot be truthfully said that the stipulation, that no alteration or amendment should affect the corporate rights of companies already organized, unless they were specially named in the amendatory act, is not an important and valuable part of the contract of incorporation.

In a case involving a similar provision in a law for the incorporation of plank road companies, the Supreme Court of Michigan said:

"It is in substance and effect but a stipulation that the corporate rights of such companies as may have been formed under this general act, shall not be affected to their prejudice, or against their consent, by any alteration of the general act not having express reference to the particular companies intended to be thus affected. In other words, that to impair any right of, or to impose any new obligation upon, such companies, by alteration or amendment, the legislative will must be exercised not generally, but with special and express reference to each particular company intended to be thus affected, *that each company may stand upon its own merits.*"

People vs. Grand Blanc Holly R. R. Co., 10 Mich., 400.

The case at bar, except in the unimportant particular that the terms of the contract are somewhat different, is identical with *State Bank of Ohio vs. Knoop, 16 How., 369.* It is not a case where the Supreme Court of the United States is concluded by the construction and decision of the State court.

The Supreme Court of the United States must necessarily decide "whether the words used are words of contract, and what is their true meaning, before it can determine whether the obligation the instrument created, has or has not been impaired by the law complained of. Now, in forming its judgment upon this subject, it can make no difference whether the instrument claimed to be a contract is in the form of a law, passed by the legislature, or of a covenant or agreement by one of its agents acting under the authority of the state."

This has been the uniform and well settled doctrine of the court.

Louisville & N. R. R. vs. Palmes, 109 U. S., 244, 256.

3. Our position is not weakened by the provisions of the constitution of Michigan, that "corporations may be formed under general laws, but shall not be created by special act, except for municipal purposes," and that "all laws passed pursuant to this section may be amended, altered, or repealed." *Art. 15, Sec. 1.*

There is nothing in these provisions which prevents the legislature from stipulating that the power to amend, alter, or repeal will be exercised in a specified manner. The constitution reserves the full power to amend, alter, or repeal, and, of course, the legislature cannot abridge or curtail that power; but it does not purport to do so when it simply provides that corporations already organized under an act shall not be affected by any act amending, altering, or repealing the original act, unless they are especially named in the amendatory or repealing statute.

Such a provision is merely the adoption in the original contract of incorporation of a rule for the construction of changes or alterations thereafter made by the legislature in the exercise of the power reserved.

The reservation of a power to amend, alter, or repeal does not give the legislature unlimited power over the corporations or their property.

Detroit vs. Detroit & H. P. R. Co., 43 Mich., 140.
Railroad Co. vs. Maine, 96 U. S., 499.
Sinking Fund Cases, 99 U. S., 700.

There is no intimation by the Supreme Court of Michigan either in the case at bar (*51 Mich., 180*), or in the prior case (*10 Mich., 400*), that section 31 might be invalid. On the contrary, both cases are a recognition of its entire validity.

In the case at bar, that court said: "No question is made of the regularity of the assessment and levy of the taxes, provided the plaintiffs are lawfully taxable by the city; but the questions raised are questions of power under existing legislation. The contention is that so long as section 31 remains in force it is not competent to tax the companies formed under this general incorporation act, otherwise than is provided by section 22. This contention does not raise a question of constitutional power. By the constitution of

1850, all acts of incorporation which should be thereafter passed were expressly made subject to alteration, amendment, and repeal; and this act may therefore be changed in the legislative discretion. The legislature might therefore have repealed section 31, had it chosen to do so. *It has not repealed it, and so long as it stands unrepealed it must be given effect.* The question, then, is whether, with section 31 in force, taxation by any other standard than that provided by section 22 is competent and admissible."

We have presented these observations on the question we are seeking to have determined on this writ of error, as the best way of showing, that whether we are right or wrong on that question, the case is one the company has a right to have reviewed by the Supreme Court of the United States.

II.

The Federal question we have considered was the only question presented by the record.

1. The form of the action was replevin.

The state statute provides that a writ of replevin shall not be executed unless an affidavit is annexed, stating "that the plaintiff in such action is then lawfully entitled to the possession of the property described in the writ; that the same has not been taken for any tax assessment or fine, levied by virtue of any law of this state; nor seized under any execution or attachment against the goods and chattels of such plaintiff liable to execution; and that such goods and chattels are unlawfully detained by the defendant in such writ."

2 How. Stat. of Mich., Sec. 8321.

The declaration simply alleges an unlawful detention of the property by the defendant.

Id., Sec. 8337.

The plea is the general issue, which is nothing more than a demand for a trial of the matters set forth in the plaintiff's declaration.

Id., Secs. 8339, 7362.

The action and the issue are of the same form in all cases, and do not show either the questions of fact or of law that may be involved.

Where property is taken for any tax or assessment the action of replevin does not lie, unless the tax is wholly unauthorized.

This was held by the Supreme Court of Michigan in a case identical with the one ~~case~~ at bar, and involving the same provisions of the street railway act.

In *Le Roy vs. East Saginaw City Railway, 18 Mich., 233*, the action was replevin for property levied upon to satisfy certain state and county and city taxes assessed against the property of the company on the theory that the specific tax of one-half of one per cent., provided for by section 22 of the street railway act, was not "in lieu of all other taxes."

The action was sustained, the point being made that under the statute replevin did not lie for property taken for taxes. The court disposed of it as follows: "To construe this provision as intended to apply only to cases in which the taxes—for which the property has been taken—have been imposed by authority of and in full compliance with the statute authorizing any particular taxes, so as to render it a valid tax, in pursuance of such statute, would be to make the question of the maintenance of the replevin depend in all cases upon the validity of the tax to be determined on the trial; and this would make the statute forbid only those actions of replevin which must equally have failed without the statute. On the other hand, to construe the statute as applying to a case in which there is no statute authority for the assessment and collection of any tax by the officers who may have undertaken to assess or collect one, and where no possible proceeding of such officers could have given them authority to impose or collect any tax under any statute of the state (or to a case where the property of some other person than the party taxed has been seized), would be to extend the statute to cases which do not come within its spirit or intent. This provision must, therefore, be construed as applying only to cases in which a valid tax might, by legal possibility, have been imposed and collected by regular and proper proceeding under some statute authority."

This conclusively shows that the form of the action, under the practice that prevails in Michigan, was such that no questions could be considered except those that involved the right of the city to levy any taxes whatever on the property of the company. Counsel for the company could only insist upon points going to show that no taxes at all could be levied, and upon the face of the statutes the only possible ground for such a conclusion is found in the proposition that the requirements or stipulations contained in section 31 of the act were a part of the contract of incorporation, and as such within the protection of the constitution of the United States.

2. The special finding of facts was such that no questions could be considered except the effect to be given to section 31.

The court simply found that the plaintiff had been organized under the train railway act, at a time when sections 22 and 31 were both in force; that the horses replevined were seized for city taxes assessed against the company in 1882, and that the proceedings by which said taxes were levied were regular and in accordance with the provisions of the city charter. Nothing more was stated, or was necessary to be stated, in order to present the question the counsel for the company relied on, viz., the force and effect, under the federal constitution, to be given to section 31. The only fact needed to present that question was that the plaintiff had been organized when sections 22 and 31 were in force, and the only fact the counsel for the city could insist upon was, that the taxes in question were regularly levied, so that there could be no question about their validity if they could be assessed at all.

How was it possible under this finding of facts for the trial court or the State Supreme Court to have passed upon any other question than that which we ask this court to consider at the final hearing of this case.

The State Supreme Court entered a judgment in favor of the defendant, for the full amount of the taxes claimed, under a statute authorizing such a judgment in replevin where the defendant on the trial establishes a lien on the property in suit.

2 How. Stat. of Mich., sec. 8342.

Considering the form of the action and the special finding of facts, such a judgment could not be rendered without deciding that section 31 was not a contract, or that the exemption from taxation provided by section 22, was not a "corporate right" within the meaning of section 31.

In this connection, we desire to call attention to some of the decisions that have been made upon this subject.

In *Crowell vs. Randell, 10 Pet., 368*, upon a review of all the prior cases, the court announced the following conclusion, viz.: that in order to bring a case within the 25th section of the judiciary act, it must appear on the face of the record :

1. That some one of the questions stated in that section did arise in the state court.

2. That the question was decided by the state court as required in the same section.

3. That it is not necessary that the question should appear on the record to have been raised and the decision made in direct and positive terms, *ipsissimis verbis;* but that it is sufficient if it appears by clear and necessary intendment that the question must have been raised and must have been decided in order to have induced the judgment.

4. That it is not sufficient to show that a question might have arisen or been applicable to the case unless it is further shown on the record, that it did arise and was applied by the state court to the case.

In *Armstrong vs. Athens County, 16 Pet., 281*, it was held that it must appear on the record itself, that the case was one within the 25th section of the act of 1879, and that it could so appear :

1. Either by express averment or by necessary intendment in the pleadings in the case.

2. By the direction given by the court and stated in the exceptions.

3. When the proceeding is according to the law of Louisiana, by the statement of facts and of the decision as usually made in such cases by the court.

4. It must be entered on the record of the proceed-

ings, in the appellate court, in cases where the record shows that such a point may have arisen and been decided, that it was in fact raised and decided; and this entry must appear to have been made by the order of the court, or by the presiding judge by order of the court, and certified by the clerk as a part of the record in the state court.

5. In proceedings in equity, it may be stated in the body of the final decree of the state court from which the appeal is taken to this court; or

6. It must appear from the record that the question was necessarily involved in the decision, and that the state court could not have given the judgment or decree, which they passed without deciding it.

If there are two defences, one presenting a federal question, and the other not, and the state court sustain *both*, the judgment below will be affirmed without considering the federal question.

Jenkins vs. Lowenthal, 110 U. S., 222.

In all the late cases the rule is uniformly stated by the court substantially as follows: "To give us jurisdiction of a writ of error for the review of the judgment of a state court, it must appear affirmatively, not only that a federal question was raised and presented for decision to the highest court of the state having jurisdiction, but that it was decided, *or that its decision was necessary to the judgment that was rendered.*"

Adams County vs. Burlington & Mo. R. R. Co., 112 U. S., 123.
Chouteau vs. Gibson, 111 U. S., 200.

In two cases it is stated that it ought to appear unmistakably that the state court "either knew, or *ought to have known*, that such a question was involved in the decision to be made."

Susquehanna Co. vs. Boom Co., 110 U. S., 57.
Brown vs. Colorado, 106 U. S., 95.

In another case it is said that the federal question must appear on the record affirmatively, *or by fair implication.*

Boughton vs. Exchange Bank, 104 U. S., 427.

II

The Federal question involved in this case was raised by counsel and fully discussed at the hearing in the State Supreme Court, and was decided by that court.

The attorneys for the plaintiff submitted a brief, and their associate in this court made an independent oral argument.

Counsel for the city in his brief in support of the motion to dismiss, has printed the brief of counsel for the company in the State Supreme Court (*see pages 15 to 24*). If it is competent to look at that brief we call attention to the second subdivision thereof, commencing on page 20, and to the proposition and cases cited in support of it, on page 21.

In addition to this evidence we have the admission made by the Supreme Court of Michigan, in the opinion of the court, as delivered by Justice Cooley. The court said.

"Different views may be taken of section 31, and were taken or suggested on the argument. It may be regarded as a contract between the state and the corporations *limiting the power of the state* for their protection so long as it remains in force," etc. The court then goes on to dispose of the question in much the same manner as that pursued by the Supreme Court of Ohio in *Piqua Branch State Bank of Ohio, vs. Knoop, 16 How., 369;* that is, the court undertakes to avoid the question by giving section 31 such *a construction* s a~~t~~ to make its provisions inapplicable to the exemption from taxation provided by section 22.

In the case cited the Supreme Court of the United States, at p. 391, said:

"The rule observed by this court to follow the construction of the statute of the state by its Supreme Court is strongly urged. This is done when we are required to administer the laws of the state. The established construction of a statute of the state is received as a part of the statute. But we are called in the case before us not to carry into effect a law of the state, but to test the validity of such a law by the constitution of the Union. We are exercising an appellate jurisdiction. The decision of the Supreme Court of the state is before us for revision, *and if their construction of the contract in question impairs its obligation*, we are required to reverse their judgment. To follow the construction of a state court in such a case would be to surrender one of the most important provisions in the Federal constitution."

IV.

It is not true that this court will not under any circumstances look into the opinions filed in the state court for the purpose of determining whether a Federal question was involved or decided.

It may not be very important, but for the purpose of showing how the opinion gets into the record or transcript returned by the clerk, we refer to the following provision of the constitution of Michigan:

"The *decisions* of the Supreme Court shall be in writing, and signed by the judges concurring therein. Any judge dissenting therefrom shall give the reasons of such dissent in writing, under his signature. All such opinions shall be filed in the office of the clerk of the Supreme Court." *Art. 6, sec. 10.*

And there is a statute to the same effect.

2 How. Stat. of Mich., Sec. 6426.

In *Grand Gulf R. R. vs. Marshall, 12 How., 165*, a case from Louisiana, the opinion was examined and referred to for the purpose of showing that the court had no jurisdiction. The opinion of the court was delivered by Ch. J. Taney, who referred to the previous decision in *Armstrong vs. Athens County, 16 Pet., 285*, and then said:

"In the case before us the proceedings were under the Louisiana law. And the opinion of the court, according to the practice in that state, is entered on the record, and sets forth the principles of law upon which the decision was made. And it appears that the decision turned upon the construction (not the validity) of the act of Mississippi of 1840, and upon a question of mere local law concerning the right by prescription claimed by the trustees."

In *Murdock vs. City of Memphis*, *20 Wall.*, *590*, the court elaborately considered the effect to be given to section 709 of the Revised Statutes of the United States. At page 633 the court said:

"It is probable that in determining whether one of those questions was actually raised and decided in the state court, this court has been inclined to restrict its inquiries too much by this express limitation of the inquiry 'to the face of the record' (*Williams vs. Noris*, *12 Wheat.*, *117*; *Rector vs. Ashley*, *6 Wall.*, *142*). What was the record of the case was pretty well understood as a common law phrase at the time that statute was enacted. But the statutes of the state and new modes of proceedings in those courts have changed and confused the matter very much since that time. It is in reference to one of the necessities thus brought about that this court long since determined to consider as part of the record the opinions delivered in such cases by the Supreme Court of Louisiana. (*Grand Gulf R. R. Co. vs. Marshall*, *12 How.*, *165*; *Cousin vs. Blanc's Executor*, *19 Id.*, *202*.) And though we have repeatedly decided that the opinions of other state courts cannot be looked into to ascertain what was decided, we see no reason why, since this restriction is removed, we should not so far examine those opinions, when properly authenticated, as may be useful in determining that question. We have been in the habit of receiving the certificate of the court, signed by its chief justice, or presiding officer, on that point, though not as conclusive, and these opinions are quite as satisfactory and may more properly be treated as part of the record than such certificates."

In *McManus vs. O'Sullivan, 91 U. S., 578,* a federal question was involved, and also other questions, upon which the case could be disposed of without reaching the federal question.

After stating these other questions the court, in an opinion by Chief Justice Waite, said: "If these questions were decided against the plaintiff, no federal question could be involved. The Record, without the opinion of the court, shows that they were presented, and does not show that any federal question was decided. Under such circumstances it is proper, if it can be at any time, to look to the opinion of the court which has been sent here with the record, to ascertain whether in point of fact the court necessarily passed by the intermediate questions and actually did decide the federal question." Looking into the opinion, it was found that in the view which the court below took of the case, a decision by it of the federal question was not necessary, and, therefore, the writ of error was dismissed by this court.

The same course was pursued in a case from Louisiana.

Crosley vs. New Orleans, 108 U. S., 105.

And also in a case from Pennsylvania.

Boughton vs. Exchange Bank, 104 U. S., 427.

In the case at bar no other question is presented by the record, and it is not possible to even suggest a question that does not involve the federal question relied upon. Under such circumstances it would seem to be perfectly proper to look at the opinion to see whether the federal question was necessarily involved in the decision that was actually made, and to supply any supposed deficiency of the record in not affirmatively reciting or stating a question within the jurisdiction of the court.

In *Gross vs. U. S. Mortgage Co., 108, U. S., 477*, the court considers the question whether the opinions can properly be referred to, and reaches the conclusion that they can. After quoting from *Murdock vs. Memphis, 20 Wall., 590*, the court say:

" We cannot, therefore, doubt that in the existing state of the law it is our duty to examine the opinion of the Supreme Court of Illinois in connection with other portions of the record, for the purpose of ascertaining whether this writ of error properly raises any question determined by the state court adversely to a right, title or immunity under the constitution or laws of the United States, and specially set up and claimed by the party bringing the writ."

Any difficulty on this subject is removed by that provision of the Revised Statutes of Illinois, which requires not only that the justices of the Supreme Court of the state shall deliver and file written opinions in cases submitted to it, but that "such opinions shall also be spread at large upon the records of the court."

We submit there is no substantial difference between spreading an opinion at large on the records and filing the written opinion itself with the clerk of the court, as prescribed by the Michigan constitution, especially when we consider that the written opinion must be authenticated by the signature of the judges, and in point of fact is as much of a record as the journal of the court.

In *Adams County vs. Burlington & Mo. R. R. Co., 112 U. S., 123, 129*, the court looked into the opinions to see whether the case was determined on a federal question, or on other questions presented by the record.

The court said:

"But if we look to the opinions, which, under the laws of Iowa, must be filed before a judgment is rendered, and which, when such is the law, may certainly be looked at to aid in construing doubtful expressions in a decree, it is shown unmistakably that the decision was put on that ground alone."

Another reason why the opinion of the state court should be looked into in this case, is the extraordinary fact, that the court below refused, when requested, to enter a certificate on the record that a federal question was involved in the case, stating as a reason therefor, that the court saw no occasion for going out of its usual course.

See sworn averments of petition for allowance of the writ of error.

We respectfully submit that the motion to dismiss or to affirm the judgment below ought to be denied.

JOHN C. DONNELLY,
F. A. BAKER,
Counsel for Plaintiff in Error.

114-133

Office Supreme Court U. S.
FILED.
FEB 25 1885
JAMES H. McKENNEY.
CLERK.

Supreme Court of the United States.

October Term 1884.—No. 923.

DETROIT CITY RAILWAY, Plaintiff in Error,

vs.

JACOB GUTHARD, Defendant in Error.

Error to the Supreme Court of Michigan.

Points submitted by Mr. Edmunds, of Counsel for the Plaintiff in Error, against the Motion to Dismiss.

The case is stated in the opening of the brief of Messrs. Donnelly & Baker, of counsel for the plaintiff in error.

I.

The legality of the tax depended on the question whether sections 22 and 31 of the Train Railways Act of 13th of February, 1885, constituted a contract of the State with the company, and on nothing else.

The form of the pleadings in the action (replevin) could not show what the point was, but the findings of the court show that the proceedings in the collection of the tax were regular, and that no question could possibly exist other